Supreme Court, U.S.
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No. _____

IN THE SUPREME COURT OF THE UNITED STATES

JOHNNY BLASTOFF, INC.
Petitioner,
v.
LOS ANGELES RAMS FOOTBALL COMPANY,
ST. LOUIS RAMS PARTNERSHIP,
NATIONAL FOOTBALL LEAGUE PROPERTIES,
INC., and
NATIONAL FOOTBALL LEAGUE,
Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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138 pp

QUESTIONS PRESENTED

1.) Whether unauthorized short-term press speculation attributing a name to an association provides priority over an intent-to-use applicant under 15 USC 1051(b) and 15 USC 1057(c)?

2.) Whether actual use and use of a trademark in the ordinary course of business are necessary to have priority over an intent-to-use applicant under 15 USC 1051(b) and 15 USC 1057(c)?

3.) Whether the subject Seventh Circuit opinion issued August 5, 1999 in Johnny Blastoff, Inc. v. Los Angeles Rams Football Company, 1999. C07.42442 <http//www.versulaw.com> ("Blastoff") conflicts with the Third Circuit's opinion issued August 3, 1999 in Lucent Information Management, Inc. v. Lucent Technologies, Inc., 1999.C03.42196 <http//www.versulaw.com>, petition for certiorari pending, ("Lucent"), creating an unresolved conflict between appellate courts which promotes commercial uncertainty, uncertainty for the United States Patent and Trademark Office records and proceedings and uncertainty for Federal Courts in determining priority?

4.) Whether a writ of certiorari should be granted in Blastoff (or in Blastoff and in Lucent with the cases consolidated) and the Third Circuit's reasoning in Lucent should be the precedent established, confirmed and followed, i.e., that "Courts cannot--award--trademark rights in an unregistered mark that

the business hopes or anticipates will be used but has not been used ..." Id., at para. 43, that an intent-to-use ("ITU") applicant "has priority over anyone using the mark after that (filing date) unless the person earlier used the mark. 15 U.S.C. 1051(b), 1057(c)," Id., at para. 34, and that "The Lanham Act provides that 'use' is the bona fide use of a mark in the ordinary course of business - - - 15 USC 1127" Id., at 55 (Ackerman, J., dissenting), such that the holding in Blastoff must be reversed, the conflict between the federal circuits resolved, and commercial certainty implemented?

5.) Whether the District Court's and Seventh Circuit's creation of trademark rights conflict with The Trademark Law Revision Act and constitutes judicial activism which is an impermissible intrusion upon the Legislature or otherwise violate the separation of powers required by the United States Constitution?

6.) Whether the Seventh Circuit's published opinion in Blastoff affirming the District Court's summary judgment decision:

6.) (i) misapplies or conflicts with the letter, spirit and legislative history of intent-to-use legislation in The Trademark Law Revision Act (1989), particularly the use definition and requirements of 15 USC 1127, 15 USC 1051 and 15 USC 1057?; and,

6.) (ii) misapplies or conflicts with cases in the Seventh Circuit of Zazu Designs v. L'Oreal, SA, 979 F. 2d 499 (7th Cir. 1992), Indianapolis Colts v.

Metropolitan Baltimore Football Club, Ltd., 34 F. 2d 410 (7th Cir. 1994), International Kennel Club v. Mighty Star, Inc., 946 F. 2d 1079 (7th Cir. 1988), Rust Environment and Infrastructure v. Teuninissen, 131 F. 2d 1210 (7th Cir. 1997), Illinois High School Ass'n v. G.E. Vantage, Inc., 99 F. 2d 244 (7th Cir. 1996), Money Store v. Harriscorp. Fin., Inc., 689 F. 2d (7th Cir. 1982), Computer Care v. Service Systems, Inc., 982 F. 2d 1063 (7th Cir. 1992), and S. Industries v. Diamond Multi-Media, 991 F. Supp. 1012 [N. Dist. Ill. 1997]?; and,

6.) (iii) misapplies or conflicts with federal cases in Circuits other than the Seventh Circuit, including Maryland Stadium Authority v. Becker, 806 F. Supp. 1236 (D. Md. 1992), Old Dutch Foods, Inc. v. Dan Dee Pretzel and Potato Chip Co., 477 F. 2d 150 (6th Cir. 1973) and Van Dyne-Crotty, Inc. v. Wear-Guard Corp., 926 F. 2d 1156 (Fed. Cir. 1991)?; and,

6.) (iv) permits judicial common law declarations based upon media speculation and strained fictions of third party analogous public use based on dicta in National Cable Television Association, Inc. v. American Cinema Editors, Inc., 937 F. 2d 1572 (Fed. Cir. 1991) to supersede Federal statutes, also violating separation of powers principles U.S. CONST. Art. 1, Sec. 1?; and,

6.) (v) denies Blastoff a jury trial under U.S. CONST. Amend VII and Fed. R. Civ. Pro. 56, with respect to whether it complied with statutory good faith filing

requirements and has a bona fide intention to use the trademark, and other disputed factual issues?; and,

6.) (vi) blocks Blastoff and others from usage of the mark "St. Louis Rams" in any United States Patent and Trademark Office ("USPTO") recognized product categories and is overbroad?; and,

6.) (vii) has a dramatic, negative, impermissible and/or unreasonable effect on trademark, name and product creation, development, licensing and merchandising, and undesirably, "holds significant ramifications for use of nicknames and slogans" (NFL press release at Petition For Rehearing in the Seventh Circuit, Exhibit. A)?; and,

6.) (viii) improperly permits the NFL to unfairly compete by allowing them to assert that they have a registered trademark in the United States Patent and Trademark Office for the team name "St Louis Rams," when they do not, in violation of 15 U.S.C. 1125 and otherwise?; and,

6.) (ix) usurps Blastoff's right of commercial free speech to develop names and products as protected by U.S. Const. Am. I, i.e., to use and have filed to reserve the name St. Louis Rams in March of 1995?; and,

6.) (x) allows the NFL's trademark registration with the USPTO for the servicemark "Rams" to avoid being declared void for "genericness" as mandated by the

precedent in Illinois High School Ass'n v. G.E. Vantage, Inc., 99 F.3d 244 (7th Cir. 1996)?; and,

6.) (xi) permits the NFL to claim a first use date of April 12, 1995, without presenting evidence based on personal knowledge, and without identifying what products may have been shipped, to whom, how and if marked, contrary to the proof requirements recognized in S. Industries v. Diamond Multi-Media, 991 F.Supp. 1012 (N.D. Ill. 1997), and under circumstances where the evidence is that the NFL could not possibly have authorized or approved inks and artwork for or on goods as of the date of NFL relocation approval on April 12, 1995, when such inks and artwork were in-fact not approved or used until June of 1995?; and,

6.) (xii) allows the NFL to have presented a fraudulent first use date to the USPTO of April 12, 1995, e.g., the shirt supposedly photographed and filed on April 26, 1995, as a "first use" sample contained an unauthorized (and never-used) logo, and the shirt was not produced in discovery?

7.) Whether the media may create trademark rights?

8.) Whether, contrary to the decision in Blastoff, a mark must be adopted in order to have a protectable mark to be consistent with the definition of trademark in 15 U.S.C 1127 and case law in the 9th Circuit?

LIST OF PARTIES

The parties to this proceeding are contained in the caption. Petitioner has no parent company nor subsidiary.

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PETITION

The petitioner Johnny Blastoff, Inc. ("Blastoff") respectfully prays that a writ of certiorari issue to review the judgment and order of the United States Court of Appeals for the Seventh Circuit, entered in the above-entitled proceeding on August 5, 1999. On August 31, 1999, Blastoff's petition for rehearing with suggestion for rehearing en banc was denied by the Court of Appeals for the Seventh Circuit.

OPINIONS BELOW

The Judgment and Order of the Court of Appeals for the Seventh Circuit in #98-2908 entered August 5, 1999 is awaiting publication and is available at 1999.C07.42442 <http//www.veruslaw.com> and is reproduced in the Appendix hereto, p. A-2 to A-26 infra. The District Court (Crabb, C.J.) dismissed Blastoff's case by the unpublished order dated June 24, 1998. <Order reproduced at Appendix p. A-27 to A-73>. The Order dated August 31, 1999 of the U.S. Court of Appeals for the Seventh Circuit denying Blastoff's Petition for Rehearing with Suggestion for Rehearing En Banc is reproduced at Appendix, page A-74.

JURISDICTIONAL STATEMENT

The jurisdiction of the U.S. Supreme Court to review the judgment and order of the United States Court of Appeals for the Seventh Circuit is invoked under 28

U.S.C. 1254 (1). The subject action was commenced March 12, 1997 in the Western District of Wisconsin. The District Court had jurisdiction under 28 U.S.C. 1331 and 28 U.S.C. 1338. On August 5, 1999, the U.S. Court of Appeals for the Seventh Circuit issued a judgment and order affirming the judgment of the District Court. <A-2 to A-26 > Blastoff's petition for rehearing and suggestion for rehearing en banc was denied by order of the Seventh Circuit on August 31, 1999. <A-74>

STATUTES INVOLVED

Text of several of the constitutional provisions and material statutes contained in Table of Authorities are set forth at length as necessary in the body of the STATEMENT OF CASE and REASONS FOR GRANTING WRIT sections of this Brief, or are contained in the APPENDIX, at A- 75 to A-98. The constitutional provisions are at A-75 to A- 76. The statutes 15 U.S.C. 1051, 15 U.S.C. 1057, 15 U.S.C. 1125 and 15 U.S.C. 1127, are at A-77 to A- 98.

STATEMENT OF THE CASE

Plaintiff Blastoff, a cartoon and sports clothing development company, commenced the subject action March 12, 1997 in the Western District of Wisconsin against defendants Los Angeles Rams Football Company, St. Louis Rams Partnership, National Football League Properties, Inc. and the National Football League, seeking a declaration of priority, and amended its complaint on September 5, 1997 seeking $100,000,000 damages for unfair competition, trademark

infringement and for cancellation of the "Rams" registered trademark due to genericness, for failure to police trademarks, and for trademark abuse (e.g., allowing the Colorado State Rams football team and others to use the "Rams" mark in an unpoliced fashion, and, a fortiori, respondents' bold assertions on various items of merchandise and promotions that respondents have a registration in the U.S. Patent and Trademark Office for the team name "St. Louis Rams"; an untrue statement to this very day.)

On January 17, 1995, an "announcement" was made by St. Louis Mayor Freeman Bosley (with Los Angeles Rams owner Georgia Frontieri standing in the background), which caused some members of the press, e.g., the St. Louis Post-Dispatch, to speculate that the Los Angeles Rams National Football League franchise might relocate to St. Louis. On February 22, 1995, Blastoff, a corporation which creates and markets sports clothing, cartoon characters, and sports team products, filed a Wisconsin trademark for St. Louis Rams, and on March 10, 1995, filed two federal intent-to-use applications ("ITU's") with the United States Patent and Trademark Office for the name St. Louis Rams, for use on sports clothing (Class 25) and in comics (Class 16). Blastoff claims it created the name "St. Louis Rams" first and filed prior to any use or use in the ordinary course of business by any of defendants/respondents.

Two days prior to the Seventh Circuit opinion in Blastoff, the United States Court of Appeals for the Third Circuit issued an opinion in Lucent Information Management, Inc. v. Lucent Technologies, Inc.,

1999.C03.42196, <http//www.veruslaw.com> where Lucent Information Management, Inc. ("LIM") asserted common law rights in an effort to establish priority over an intent to use application ("ITU") filed by Lucent Technologies, Inc. ("LTI"). The Third Circuit holding that LIM's limited (but actual) use of the mark and desire to use the mark did not constitute prior use in commerce sufficient to establish rights in the "Lucent" mark Id., at para. 15.A certiorari petition is pending in Lucent. The other facts necessary to determine whether to grant a writ of certiorari in Blastoff are contained below. In Lucent, the ITU controlled.

REASONS FOR GRANTING THE WRIT

Blastoff contends that both the District Court on summary judgment and the Seventh Circuit Court of Appeals utilized judicial fictions to find "use" in order to create priority of the trademark "St. Louis Rams" in favor of the defendants, who comprise the National Football League, over Blastoff, which had filed its ITU's in good faith in Class 16 (paper goods) and Class 25 (clothing) with a bona fide intention to use the trademark St. Louis Rams as required by 15 USC 1051(b), and for which petitioner Blastoff claims nationwide priority because defendants had no prior actual use nor use in the ordinary course of business as required by 15 USC 1057(c) and 15 USC 1127.

In Lucent, the Third Circuit declared what Blastoff, in substance, had argued was the proper standard for Courts to follow:

"Courts cannot - - award - - trademark rights in an unregistered mark that the business hopes or anticipates will be used but has not been used" - - Lucent, at 43, and that an intent to use applicant has priority except as to a person who has actually used the mark, Id, at 33, citing 15 USC 1057(c), and, that use must be in the ordinary course of business for purposes of determining priority, 15 USC 1127, at 55. (Ackerman, J., dissenting).

It is undisputed in Blastoff: (i) that any press speculation regarding relocation of the NFL's Los Angeles Rams franchise was unauthorized, (ii) that any use of the name "St. Louis Rams" by an NFL franchise or licensee was in fact prohibited by the NFL, (iii) that the press conference held January 17, 1995, was unauthorized by the NFL and was not in the ordinary course of business of Los Angeles Rams Football Company, (iv) that the NFL owned all NFL trademarks at all material times, not the Los Angeles Rams Football Company, (v.) that Paul Tagliabue, NFL Commissioner, spokesman, and trademark trustee for all teams and trademarks for the NFL, publicly opposed any relocation by the Los Angeles Rams in the press (USA Today) on the day before Blastoff's ITU filings, but this particular NFL press release was authorized, and, (vi) that the NFL had filed an intent-to-use application for the mark St. Louis Stallions, which was published for opposition without withdrawal in the Official Gazette on January 17, 1995 (same day as the Los Angeles Rams Football Company's "announcement") and was allowed on April 11, 1995; and, which application (i.e., for the name St. Louis Stallions) showed-up in Blastoff's pre-filing formal trademark search. Further, the NFL confirmed

Tagliabue's opposition by voting down any relocation by the Los Angeles Rams franchise on March 15, 1995, and (vii) the NFL reversed its decision and approved a relocation, but not disclosing the new team name or logo, on 4/12/95, and (viii) the NFL's first approved or authorized use of St. Louis Rams approved logo was after June 27, 1995. There is no way to have found or concluded the existence of any "use" by defendants prior to March 10, 1995, under 15 USC 1127 or otherwise.

The Seventh Circuit panel's published decision in Blastoff issued August 5, 1999, inter alia,

A.) conflicts with the legislative mandate, spirit and intent of the Trademark Law Revision Act (1989) (the "Act"), which created and encouraged intent-to-use legislation and defined use; and,

B.) clashes with Zazu Designs v L'Oreal, S.A., 979 F.2d 499 502-03, (7th Cir. 1992) which acknowledged the reality of the Act and also specifically required use to establish rights; and,

C.) misapplies or clashes with Indianapolis Colts, Inc. v Metropolitan Baltimore Football Club, Ltd., 34 F. 3d 410, 416 (7th Cir. 1994) (nothing prevents anyone from using "Colts" for anything other than a professional football team), as well as the subsequent case of Rust Environment and Infrastructure v. Teunissen, 131 F. 3d. 1210, 14, 15, 20 (7th Cir. 1997), which limited Indianapolis to its facts; and,

D.) relies upon outdated, uncertain and superseded judicial legal fictions of common law public analogous use lurking in dicta in pre-Act circumstance cases like National Cable Television Association, Inc. v. American Cinema Editors, Inc. 397 F. 2d 1572, 1576-78 (Fed. Cir. 1991), relying upon Coca-Cola Co. v. Busch, 44 F. Supp. 405, 409-410 (D. Pa. 1942), where everyone had used the abbreviation "Coke" for at least 10 years. Id, at 409; and,

E.) clashes with the Seventh Circuit's the holding of genericness and invalidity of registration for the mark "March Madness" resulting from more than one user of the mark in Illinois High School Ass'n v. G.E. Vantage, Inc., 99 F.3d 244 (7th Cir. 1996).

F.) This case isn't just about an NFL franchise relocation, its about sophisticated and powerful merchandising companies being about to control many names and supersede federal legislation based upon short-term press speculation. Its about companies warehousing marks and monopolizing names, slogans and products they haven't used or even filed intent-to-use applications for, and which others may have invented, reserved, or used. As to the relocation issue, the NFL had a pending intent-to-use application for the mark St. Louis Stallions, which was published in the Official Gazette without withdrawal on the same day as the press conference analyzed in the case at bar, this aspect revealed in Blastoff's February, 1995 trademark search and presented in evidence, but rejected by the District

Court and by the Court of Appeals. There is no way that a team name "St. Louis Rams" for the NFL was anything other than speculation at all material times. The Houston Oilers are now the Tennessee Titans, not the Nashville Oilers. The Cleveland Browns became the Baltimore Ravens, not the Baltimore Browns. Now we even have the Cleveland Browns again. Further, the relocated team, if it received NFL approval and moved, could very well have been the Missouri Rams, since Missouri Senator Thomas Eagleton was also at the press conference <R-43, PPF/C #36>, and he signed the Relocation Agreement <R-42, at pg. 17>, and, since proposed personal seat licenses promoted by a third party for seats in the then-yet-unnamed stadium (now named the Transworld Dome), for possible games of then-yet-unnamed team ("an NFL franchise") only used "Rams" in the sales contract to indicate a shortened reference for Los Angeles Rams Football Company. <R-42, pg. 15-16> Los Angeles Rams Football Company was previously known as Baltimore Football, Inc., when it operated the Baltimore Colts NFL franchise in the early 1970's, and the Baltimore Colts did not become the Los Angeles Colts, nor did the Los Angeles Rams become the Baltimore Rams upon relocation. R-42, #1, pg. 2. NFL Commissioner and trademark trustee, Paul Tagliabue, from January through at least April 12, 1995, publicly opposed relocation and wanted the nickname "Rams" to stay for use in Los Angeles even if the franchise or team eventually relocated. R-42, #18, at pg. 6. The St. Louis Cardinals are now the Arizona Cardinals, not the Phoenix Cardinals, even though there still is a

sports team known as the St. Louis Cardinals. History shows that predicting team names following a relocation is nothing more than pure speculation.

G.) To permit the NFL to continue to claim publicly that they have registered trademarks for all NFL team names, when they don't, is a miscarriage of justice. 15 U.S.C. 1125. <NFL Press Release 8//11/99 at Petition for Rehearing Exhibit A.>

H.) Businesses can't rely on third party media speculation for creation of rights in this day and age of mass and conflicting information, much of which is speculative and unreliable. There is also a distinction between press speculation and whether a significant portion of the public actually made a certain association of a name with a company, even if some enthusiastic members of the press, i.e. the St. Louis Post-Dispatch who mocked-up a banner at the press conference <R-42, #41> and issued an unauthorized multi-page article the next day, and Mayor Bosley, who also was unauthorized, who, advocated the name "St. Louis Rams" without authorization from anyone connected with any of the defendants. <R-42, #22.> The NFL "Rams" actually relocated headquarters to Earth City, MO not St. Louis, <R-42, #1>, but they used to play in Anaheim, not L.A. <R-43 #55>. Blastoff first used the name St. Louis Rams on Dec. 6, 1993 in connection with a telephone solicitation of a Chicago area clothing buyer. R-43, #23(d), #62, R-42, #157, and is not trying to "palm-off" itself as the NFL. <R-43, #84>;

At R-41, Exhibit 52, Blastoff's letter to various potential licensees and businesses states:

> "We are developing characters and products, including some with our name and logo, St. Louis Rams. Our products are anticipated to include futuristic animated characters, real and imaginary city sports teams, as well as various clothing, printed materials, a wine cooler product, beer and cigars. Our products are not affiliated with any NFL team."

I.) The Seventh Circuit panel found, at Opinion page 10, <A-13> that:

> "Georgia Frontiere, owner of the Rams, in announcing her intention to move the franchise to St. Louis from Los Angeles implicitly adopted the exact phrase "St. Louis Rams" on the date of her press conference. This Court's decision in Indianapolis Colts is strong support for the proposition that the Rams organization and the NFL had a long-established priority over the use of the "Rams" name in connection with the same professional football team, regardless of urban affiliation."

First, there does not appear to be any support in law for an "implicit adoption". <R-43, #115> There can't be an "implicit adoption" under these circumstances in trademark law; it is neither use nor in the ordinary course of defendants' business. 15 USC 1127. Second, it is ironic that this decision was issued just days before the Cleveland Browns played in Cleveland on Monday Night Football on August 9, 1999, [a post-judgment fact

may be noticed in connection with an appeal, Landy v. Federal Deposit Insurance Corp., 486 F. 2d 139, 150-51 (1973).] The Cleveland Browns franchise relocated to Baltimore and became the Baltimore Ravens, not the Baltimore Browns. Id. <Baltimore Ravens filed for the mark in 1993. R-41, Exh. 6.>

J.) The panel, at Op., page 9, <A-12> relied on the pre-Act Federal Circuit case of National Cable for authority that substantial public use alone may creates common law rights. National Cable should not apply to the case at bar, and should be explicitly updated, distinguished, or rejected. R-43, #21(a). In National Cable, "there is no dispute that Editors has long prior rights in ACE as a collective mark used by its members in connection with film editing", Id, at 1576, and, "in 1971, Editors entitled a publication 'ACE SECOND DECADE ANNIVERSARY BOOK." Id, at 1577 Dicta in National Cable, adopted by the panel at pg. 9, <A-12> suggested that "abbreviations and nicknames of trademarks or names used only by the public give rise to protectable rights in the owners of the trade name or mark which the public modified. Such public use by others inures to the claimant's benefit and, where this occurs, public use can reasonably be deemed use "by" that party in the sense of a use on its behalf." Id. (emphasis in original).
"St. Louis Rams", however, is not an abbreviation or nickname of "Los Angeles Rams" or "Rams". Further, as referenced at oral argument "however, the use by the public of a term to refer to a company and/or its products or services does not mean that the company has obtained rights to exclude others from using the same term for

any product or service" Big Blue Products, Inc. v. IBM, 19 USPQ 2d 1076, 1079 (TTAB, 1991).
A potentially relocated team doesn't mean the nickname stays the same, notwithstanding dicta in Indianapolis. A team name may have a State or Regional geographic component (Minnesota Vikings). Sales of personal seat licenses referencing "Rams" [for Los Angeles Rams Football Company, Inc.] by a third party (FANS, INC.) (i) isn't use of the name "St. Louis Rams" in the ordinary course of defendants' business, 15 USC 1127, and (ii) doesn't mean the nick-name or geographical designation in the team name is decided, adopted or established, even if the NFL approved any franchise relocation, which was undisputedly doubtful when Blastoff filed its ITU's on March 10, 1995. "Rams" and "Los Angeles Rams" are not "St. Louis Rams", since "what may seem minor to the trademark owner modifying his mark way, from the standpoint of maintaining continuous priority rights, result in an entirely new mark with its own, and later, priority." Van Dyne-Crotty, Inc. v. Wear-Guard Corp. 926 F. 2d 1156, 1159-60 (Fed. Cir. 1991). The "salient portion" of the mark is "St. Louis Rams", not "Rams" or the "ramhorn" design of defendants. See, International Kennel Club v. Mighty Star, Inc., 946 F. 2d 1079, 1088 (7th Circuit 1988).

K.) The Trademark Law Revision Act (1989) (the "Act"), defines "Use" under 15 USC 1127, since intent-to-use is now available under 15 USC 1051(b) and 15 USC 1057, this affects how a Court should determine both use and priority. The Panel, at page 10, <A-14> relied on a pre-Act case, suggesting that a "trademark

application is always subject to previously established trademark rights of another party. , See The Money Store v. Harris Corp Fin. Inc., 689 F. 2d 666, 672 (7th Cir. 1982)." The Act, however, changed some aspects of how businesses must operate, encourages reliance on the U.S.PTO records and provides for ITU filings which eliminate judicial legal fictions which may favor larger companies, all to promote commercial certainty. R-43, #24-#27, #92. Zazu, at 502-03, acknowledged the Act's impact, and warned that "companies need only search the records before embarking on development". Id, at 503-504; R-43, #90. The NFL didn't follow its own practices of searching USPTO records and filing ITU's. <R-43, #20-9, #91.>

L.) Its not just the geographical relocation of football franchises that this case effects. We live in a world of mergers, reorganizations, information, product branding, media speculation and restructuring of businesses and associated name changes. Intent to use legislation, 15 USC 1051, 15 USC 1057, got lost somehow and was in effect trumped by this decision. Congress intended to level the playing field for small companies and encouraged trademark searches and follow-up searches of the USPTO records. Senate Hearing on Trademark Law Revision Act of 1988, Gilson, at VI-272.61, Id, at VI-272, 103-04. On remand, an ultimate issue at trial should be whether Blastoff filed its ITU's in good faith with a bona fide intention to use the mark on the goods which Blastoff specifically identified in Classes 16, 25, 32, 33 and 34 under 15 USC 1051 and 15 USC 1057. 15 USC 1127 requires use by the NFL in the ordinary course of business, which simply didn't exist without

NFL approval and without Paul Tagliabue's blessing as NFL Commissioner and trustee of the trademark "Rams". R-42, pg. 13-14. The press conference wasn't authorized by the NFL, wasn't in Georgia Frontiere's permitted territory of Los Angeles, and didn't contain the obligatory T-shirts and hats you see when a sports team press conference is held in the ordinary course of business. Id. Paul Tagliabue publicly declared no move both before and after Blastoff's ITU applications were filed. R-43, #23(d). Rigsby, President of Blastoff, called LARFC before and after the appellant's ITU filings, but LARFC indicated "they didn't know who they were." R-43, #17-3 at 13. He ran a formal search and saw a pending ITU for "St. Louis Stallions" with the NFL as applicant published for opposition on 1/17/95. <R-41, Exh. 58, pg. 35-36>. St. Louis Rams was simply not adopted by nor distinctive as to defendants at a meaningful time. Computer Care v. Service Systems, Inc., 982 F.2d 1063, 1069 (7th Cir. 1992).

M.) Judge Posner pointed out in Indianapolis that if a party "wants to use 'Colts' in conjunction with anything besides a Baltimore football team, there is nothing in this lawsuit to prevent them." Id, 34 F.3d, at 416. Blastoff has priority, certainly in the goods identified in applications in classes 16 (comics, papergoods), 25 (clothing), 32 (fruit juice, water, Beer), 33 (wine, liqueur) and 34 (cigars) as filed by Blastoff with the USPTO. <R-42, #162>

N.) The panel held, at Op., pg. 9,<A-12 - A-13>, that "Blastoff has failed to demonstrate any equivalent use of the mark "St. Louis Rams" by February of 1995,

when the defendants established, by use and public association, their priority in the mark." There was no use by defendants, and the "public association" is actually pure short-term press speculation, and not use under 15 USC 1127 or use as required in Zazu. Blastoff doesn't have to demonstrate use, only a bona-fide intention to use as an applicant who filed with the USPTO in good faith. R-42, #57; 15 USC 1051, 15 USC 1057, 11 USC 1127.

O.) Money Store, at 672 is also misapplied by the panel at Op., p. 10, <A-14>. If anything, Money Store, at 672, (i) justifies Blastoff's conduct and ITU filing, by Blastoff's having conducted a full trademark search in February, 1995 <Widule Aff., R-41, Exh. 58> to determine whether any pre-existing rights exist, and, (ii) condemns Defendants' conduct, because they conducted no search, or, if they did, they filed applications after constructive knowledge Blastoff's, in either case playing "business Russian roulette". Tr. Pro. and Pr, Gilson, Vol. 3, Sec. 3.01 [2], pg. 3-8, 9, at R-43, #49 and R-42, #163.

Old Dutch Foods, Inc. v. Dan Dee Pretzel and Potato Chip Co., 477 F.2d 150, 154 (6th Cir. 1973) cited at Op. p. 10-11 <A-14> for the proposition that a company may have two trademarks at the same time (and therefore concluding that publicly operating as the Los Angeles Rams until April, 1995 was "irrelevant") is a misapplication of Old Dutch, at 155, which dealt with the actual use of two marks.

In Indianapolis, Judge Posner declared "No one questions the validity of Indianapolis Colts as the trademark of the NFL team that plays out of Indianapolis

and was formerly known as the Baltimore Colts", Id, at 413. The case at bar challenges precisely that issue. In Indianapolis, at 411, we see that in 1952 the "Dallas Texans" of the NFL moved to Baltimore and, after NFL approval, officially called themselves the "Baltimore Colts" (rather than the "Baltimore Texans" as the NFL defendants, to be consistent, would have to assert.) The NFL permission was, and still is, the key factor in creation of the team name, regardless of whether the players remain the same. Indianapolis, at 413, Op., pg. 10 <A-13>.

P.) "Ram" has been famous a long time, way before the NFL. e.g., Holy Bible, Rev. St. Ed., Book of Genesis, Chpt. 22. [That's one reason why this particular animal was chosen from all those in the ark. Indianapolis, at 412, <R-43 at #104; R-42, #93>.] As to the NFL's rights to "St. Louis," the Crusader, King Louis IX, predated the NFL by centuries. The panel's conclusion, at Op., p. 16-17, <A-17 to A18> that "Rams" is not generic because the Colorado State Rams is a college football team and the NFL a professional football team conflicts squarely with that Court's decision in Illinois High School Ass'n v G.E. Vantage, Inc., 99 F. 3d. 244 (7th Cir. 1996). (Use of names in High School and College are not different, the level of sports competition is irrelevant.)

A fortiori, the evidence in the case at bar is that sports clothing for both college and professional levels are marketed to the same consumer market, channels, and are displayed in the same stores. <R-39, #3, pg. 4; R-43, #112> The NFL's Rams trademark and registration are dead; they are generic, Illinois, at 247.

Q.) The conclusion about Blastoff's unfair competition claim failing due to lack of standing, at Op., pg. 17 <A-22 to A-23> is also a tragedy because a large company has a standard business practice of publicly asserting that its team names are registered trademarks with the USPTO when they aren't. [See, Exhibit A; NFL St. Louis Rams press release of 8/12/99, which may be considered in connection with appeal. Landy.] Registered means registered with the USPTO. Black's Law Dictionary, West Publ. (1979), at 1154. R-42, #20, likewise for industry standards. R-80, pg. 17-18, item 11-H. Even today the NFL's St. Louis Rams trademark applications are still suspended and not registered. R-43, #22(c), 27, 40, 41, 83.; USPTO #74/666,081.

R.) The NFL's "evidence" alleging a shipment of merchandise in April of 1995, without specifying exactly what goods where sold, and to whom, and establishing which particular version of a mark might have been used, is excludable evidence as a matter of law. S. Industries v. Diamond Multi-Media, 991 F. Supp. 1012, 1019-20 [N. Dist. Ill. 1997].

S.) The panel's reliance on Maryland Stadium Authority v. Becker, 806 F. Supp. 1236 (D. Md 1992) is also in error, and, in fact, establishes Blastoff priority. Geographic designations are descriptive word marks. Id, at 1239. To obtain trademark rights in a descriptive word mark, it must be adopted and used, Id, and it must have acquired secondary meaning. Id.
"Camden Yards" became associated with the complex back in 1987, four years earlier. Id. Contra, case at bar.

MSA, itself, had referred to the project as Camden Yards sports complex for many years including their written disseminated plans. Id. Contra, case at bar. Becker had no ITU filings. Contra, case at bar. MSA answered inquires from the public that they were "Camden Yards". Contra, case at bar. The Maryland Court did not rely on press reports or short term media speculation, that Court relied on specific advertising and promotion created by and used by the party seeking to established rights. Contra, case at bar. What the New York Times, USA Today and St. Louis Post-Dispatch reported is irrelevant or, even if not, when Paul Tagliabue appeared on the front page of USA Today saying no move, the very same day as Blastoff's ITU filings, the "omnipresent media" recognized in Indianapolis, at 247, obviated and eliminated any degree of certainty in whatever previous reports may have implied or suggested. If LARFC had any other intentions: (1) it didn't articulate them and (2) it could have strengthened its priority argument by earlier ITU filings than April 26, 1995, seven days after Blastoff's filings became commercially available information. R-42, #61, R-43, #45, 57, 60, 90. The little (or big) guy (or gal) who follows the rules should prevail legally and decisions which recognize compliance with the Act provide business certainty; that's what's important about this case. In Maryland there was certainty of the name being the mark in dispute. Id., at 1240-41. Contra, case at bar. In Maryland, Becker copied MSA's mark. Id., at 1241. Contra, case at bar. See, e.g., Op. page 1,2 <A-3>: Blastoff had "a separate and distinct, fictional, cartoon sports team, the "St. Louis Rams." See, also, A-99.

T.) Section 15 USC 1127 defines "trademark" and requires use to have a trademark in the first instance or the filing of an ITU. The definition of use in commerce applies to all aspects of the Lanham Act. Gilson, Trademark Protection and Practice, Sec 13, pg. 13-32, hearing on H.R. 4156 (Trademark Law Revision Act-1988), Statement of U.S. Trademark Association. Only active use allows consumers to associate a mark with particular goods. Zazu, at 502-03, and an unregistered plan creates no rights. Id, at 504.

Intent to use legislation was created to eliminate uncertain judicial common law fictions. It "increase(d) certainty as to the availability and protectability of new trademarks, while doing away with the doctrine of token use to reserve a mark. Token use tends to be discriminatory in favor of large companies --- and it promotes and perpetuates legal fictions. It has produced a body of case law fraught with the potential for inconsistent results." American Bar Association Section of Trademark and Copyright Law, letter to chairman Kastenmeier re: proposed Trademark Law Revision Act of 1988, page VI-410, 246, 248.

U.)Blastoff is, at minimum, entitled to a jury trial to see whether he has statutory priority as of March 10, 1995, or otherwise filed in good faith. 15 USC 1051, 15 USC 1057, Byrd v. Blue Ridge Electric Cooperative, Inc., 356 U.S. 525, 537 (1958); U.S. CONST. Amend VII; Fed. R. Civ. Pro. 56; Lucent, (dissent). (the majority opinion in Lucent held that LTI filed its ITU in good faith, despite LTI's trademark search revealing the use of the "Lucent" mark by LIM.

V.) Courts should not create rights for larger companies contrary to a federal statute. U.S. CONST. Article I, Sec. I., U.S. CONST Article III. Football is the national pastime, at least for now, but that is no reason to trump federal law. In Marbury v. Madison, 5 U.S. 137 (1803), the Supreme Court made it clear that a Court should only refuse to follow a federal law which is unconstitutional. The Trademark Law Revision Act is not unconstitutional.

> "The constitution vests the whole judicial power of the United States in one Supreme Court, and such inferior courts as congress shall, from time to time, ordain and establish. This power is expressly extended to all cases arising under the laws of the United States; and consequently, in some form, may be exercised over the present case because the right claimed is given by a law of the United States".

Marbury, 5 U.S. 137, 1 Cranch 137, 174-175 (1803).

W.) To allow the Courts to vary from explicit and thoughtful legislative mandates seems be an impermissible, variation of judicial activism. As noted in Henry Harper v. Virginia Department of Taxation, 1993.SCT. 3753 <http://www.versuslaw.com>, ___ U.S.___, 113 S. Ct. 2510, 125 L. Ed. 2d 74, 61 U.S.L.W. 4664, at para. 61, in the analogous context where a Court departs from prior case law: "In the eyes of its enemies, the doctrine (judicial activism) "smaked of the legislative process", Mishkin, 79 Harv. L. Rev., at 65, "encroached on the prerogatives of the legislative department of government", Von Moschzijker, Stare

Decisis in Courts of Last Resort, 37 Harv. L. Rev. 409, 428 (1924), removed "one of the great inherent restraints upon this court's departing from the field of interpretation to enter that of law making" James v. United States, 366 US 213, 225, 6 L. 2d 246, 81 S. Ct. 1052 (1961) (Black, J., concurring in part and dissenting in part), and caused the Court's behavior to become "assimilated to that of a legislature..." Id. In Henry Harper, at para. 60, Justice Kennedy, with whom Justice White concurred, reminded us that "it is 'the province and duty of the judicial department to say what the law is 'Marbury v. Madison, 5 U.S. 137, 1 Cranch 137, 177, 2 LEd. 60 (1803)."

Petitioner contends that this province and duty should not be misused to circumvent a legislative mandate which is wholly constitutional. While it seems axiomatic that "courts must follow the law", one computer search reveals no case in this Court that specifically declares or reaffirms this requisite truth, Courts must follow the law passed by the legislature. It is respectfully contended that a declaration by the United States Supreme Court that courts must follow the law will provide a temperament to reassure a nation that longs for the days of when both business and justice were simple, predictable, and fair to the little guy (or gal) who worked hard and played by the rules. Media speculation alone is much too fickle, transitory, and unreliable to be "construed" as use or use in the ordinary course business. See, e.g. 15 USC 1125 (c)(4)(c).

At oral argument in the Seventh Circuit, on the morning of December 1, 1998, petitioner requested that the

appellate panel take judicial notice that Mobil and Exxon had announced that very morning an intention to merge, but no one in that Courtroom could identify the name of the "new" company, because it hadn't been decided or announced yet, and to do so was pure speculation. Blastoff faced a similar situation when Blastoff's ITU's were filed on March 10, 1995, with the United States Patent and Trademark Office. In fact, Blastoff's trademark search showed the NFL had reserved the name St. Louis Stallions. When the senior in priority gets swamped later on by the more powerful junior in priority, that's what a reverse confusion case is all about. Sands, Taylor & Wood Co. v Quaker Oaks Co., 978 F. 2d 947, 957 (7th Cir. 1992).

X.) Just as the NFL preserved the history of the Cleveland Browns for the Cleveland area, in the case at bar the NFL publicly indicated the intention to preserve the Los Angeles Rams history in and for the Los Angeles area [e.g., NFL press releases 3/10/95, NFL vote of "no" to relocation on 3/15/95, Commissioner's insistence that any relocation required the "Los Angeles Rams" name to stay for use by the NFL in Los Angeles, NFL pending trademark application for St. Louis Stallions.] "Los Angeles Rams" was registered at all material times with the USPTO by defendants in Class 41 (service mark in entertainment, pro football) with the integral designation of a distinctive geographical location in Los Angeles, as opposed to having merely disclaimed the geographical component. Any strained purported use of the name "St. Louis Rams" by any of defendants or licensees was in fact prohibited by the NFL constitution and By-laws until well after Blastoff's

ITU's. As evidenced by the Declaration of Paul Tagliabue < R-41, Exhibit 7>, the league determines where a member plays in all cases.

Y.) Blastoff had the right of commercial free speech to use and file ITU's for the name St. Louis Rams in March 1995, U.S. CONST Amend. I. It would be unfair competition to allow the "Rams" later registration or media speculation to prevent Blastoff from reserving the name St. Louis Rams under the Lanham Act. <R-43, PPF/C #78(a).> 15 USC 1051(b); 15 USC 1057; Singer Manu. Co. v. June Manufacturing, 163 US 169, 184-189, 203, 16 S.Ct. 1002, 41 L.Ed. 118 (1896); 15 USC 1125; In Re Northern Pigment Co. Cust. And Patent App., 71 F.2d 447, 453-54 (___ Cir. 1934) (can't monopolize industries or stop people from developing names and products); Wisconsin Electric Co. v. Dunmore, CCA Ohio, 35 F.2d 555, 557 (6th Cir. 1929) (Wis. Unfair Comp.-all have equal rights in the use of language).

Z.) In the Dist. Ct. Op. of June 24, 1998, p.36 <A-61>, the District Court cited Illinois High School Ass'n. v. G.E. Vantage, Inc., 99 F.3d 244, 276-77 (7th Cir. 1996) for the proposition that the Seventh Circuit would likely conclude that the media may create trademark rights. Illinois High School, however, provides that a reverse confusion case is available in the 7th Circuit if the junior markholder "blots out" the senior mark holder from the marketplace. Illinois, at 246-47. Therefore, Plaintiff may sue for reverse confusion in the 7th Circuit. Furthermore, the Illinois High School case stands for the proposition that the media or public perceptions do not

create trademark rights. Importantly, Judge Posner declared that "the existence of a mark that designates a particular source is presupposed." Id., at 247. There was no (NFL) St. Louis Rams mark as of Blastoff's March 10, 1995, filing. Consequently the presupposition recognized and required by the 7th Circuit in Illinois High School, was not satisfied in Blastoff. Furthermore, under Illinois High School, the media can only kill a mark, not create one. Id. ("... the public -egged on by the omnipresent media, decides to use a trademark not the particular manufactures brand ... the trademark is dead..." Id., R, 80, pg. 8-9. Also, " for the sake of ... effective communication (public use) should be resolved against trademark protection ...." Id., at 247. (parenthetical added). Thus, the Illinois High School case suggests exactly the opposite of what the District Court concluded, at Opinion of June 24, 1998, S.A., Exh. A., pages 36 and 39 <A-61, A-64>. (e.g. that "the public "use" of the mark directly following defendants January 1995, relocation announcement gave defendants priority rights in the mark over Plaintiff's subsequent state registration, federal applications and minimal sales and marketing." Id.). In the Seventh Circuit, however, public use doesn't create protectable trademark rights, but it can destroy existing rights, even to the point of genericness. In Illinois High School, the Seventh Circuit found "March Madness" generic, not because it signaled something crazy happening in March, but found genericness existed even though only two locations of basketball tournaments were mentioned, Id., at 246. In Illinois High School, the NCAA was, in effect, prohibited from exclusive trademark rights despite the public's association with the NCAA as the source of

March Madness (not some type of analogous use of a similar mark creating June Madness of March Sadness or some other "modification" or "nickname"). In fact, even though the NCAA was the primary source of the definitive mark "March Madness" it was still subject to a finding of genericness. Id., at 247. Plaintiff here has a stronger case than that pled as unfair competition by Illinois High School and allowed to go to trial in Illinois. R, 80, pg. 10.

AA.) Defendant(s) did not sufficiently adopt the mark St. Louis Rams as of March 10, 1995, the date of Plaintiff's federal ITU applications. <R, 42, Resp. To DPFOF #2> A trademark must be used after its adoption to be afforded priority. In New West Corp. v. NYM Co. of Cal., Inc., 595 F.2d 1194, 1200 (9th Cir. 1979):

> "The question of use adequate to establish appropriation remains one to be decided on the facts of each case, and that the evidence showing, first adoption, and second use in a way sufficiently public to identify or distinguish the marked goods in an appropriate segment of the public mind as those of the adopter of the mark."

It was the (hopeful) mayor of St. Louis that said "St. Louis Rams" at the press conference, not Georgia Frontiere or anyone else from the defendants. <R, 42 Resp. To DPFOF #11; Resp. To DPFOF #13; Resp. To DPFOF #40; Resp. To DPFOF #41; Resp. To DPCOL #151 citing 15 U.S.C. 1127; R, 43, PPF/C #37; PPF/C #115; R, 80, pg.2>. The District Court also observed that an idea or conception is not protectable, <Opinion,

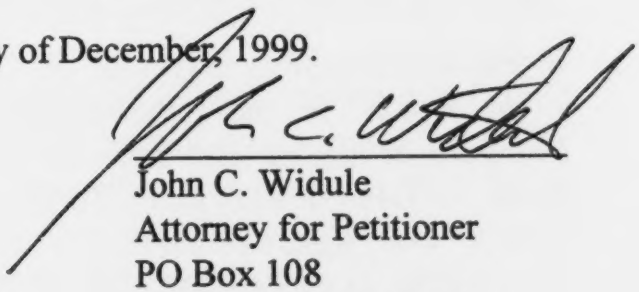
of June 24, 1998, page 30-31, A-55>, so even if "St. Louis Rams" is what Ms. Frontiere's unarticulated idea for the team may have been, Los Angeles Rams Football Company is not to be given priority. The St. Louis mayor, and the City of St. Louis wanted any NFL team, not necessarily any particular team, or team name. [e.g., "St. Louis Stallions" was o.k. with fans, and the NFL publicly announced that the public shouldn't "jump the gun." St. Louis Post Dispatch, 1/17/95, at Heberer Aff., R, 34, Exh. K, Doc. #J00148 quoting officer of NFLP; also, that "Another team would move to St. Louis with NFL Blessing." USA Today, 3/17/95, at Heberer Aff., R, 34, Exh. L, Doc #J00687]; R, 80 pg. 2-3.

BB.) At A-99 is an actual sized excerpt from Blastoff's ITU application #74/644,300<R-41, Exh.#40, pg. 9> filed March 10, 1995, with the USPTO for Blastoff's St. Louis Rams logo to be used on sports clothing.

Conclusion:

This case warrants issuance of a writ of certiorari to the United States Court of Appeals for the Seventh Circuit.

Dated this 17th day of December, 1999.



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In the
United States Court of Appeals
for the Seventh Circuit

No. 98-2908
JOHNNY BLASTOFF, INCORPORATED,

Plaintiff-Appellant,

v.

LOS ANGELES RAMS FOOTBALL COMPANY, ST. Louis RAMS PARTNERSHIP, NATIONAL FOOTBALL LEAGUE PROPERTIES, INCORPORATED, et al.,

Defendants-Appellees.

Appeal from the United States District Court
for the Western District of Wisconsin.
No. 97 C 155-Barbara B. Crabb, Judge.

ARGUED DECEMBER 1, 1998-DECIDED AUGUST 5, 1999

Before COFFEY, ROVNER and DIANE P. WOOD, *Circuit Judges.*

COFFEY, *Circuit Judge.* On January 17, 1995, St. Louis Mayor Freeman Bosley and Georgia Frontiere, owner of the Los Angeles Rams Football Company ("Rams"), a National Football League professional sports team, announced that the Los Angeles Rams football franchise intended to relocate to St. Louis, Missouri, from Los Angeles, California. Shortly thereafter, on February 22, 1995, the plaintiff-appellant Johnny Blastoff, Inc. ("Blastoff"), a corporation in the business of creating and marketing cartoon characters, filed a State of Wisconsin [2]trademark application for the name of a separate and distinct, fictional, cartoon sports team, the "St. Louis Rams." On March 10, 1995, Blastoff filed two federal intent-to-use trademark applications for the "St. Louis Rams" mark. One month later, on April 12, 1995, the Rams' move to St. Louis was approved by the National Football League ("NFL"). On March 12, 1997, the plaintiff-appellant Blastoff filed a complaint in the United States District Court for the Western District of Wisconsin, seeking a declaratory judgment against the defendants-appellees, the Rams, the NFL, National Football League Properties, and the St. Louis Rams Partnership. Specifically, Blastoff sought declarations that: (1) the Rams had engaged in unfair competition, including misrepresenting the registration status of the "St. Louis Rams" mark; and (2) Blastoff did not infringe the NFL defendants' trademark rights. On September 5, 1997, Blastoff filed an amended complaint, seeking $100 million in damages and further declarations of unfair competition, trademark infringement, and cancellation of the Rams' registered trademark for the "Rams" mark. On March 12, 1998, the

NFL moved for summary judgment, seeking an order dismissing the First Amended Complaint in its entirety, which the trial judge granted. The judge also granted the NFL's counterclaim for injunctive relief and ordered the State of Wisconsin to cancel Blastoff's registration of the mark "St. Louis Rams." Blastoff appeals. We affirm.

I. BACKGROUND

The Blastoff corporation was organized under the laws of Wisconsin in 1993. Rodney Rigsby ("Rigsby") is president, chairman of the board, and primary shareholder of Blastoff. The corporation, which is in the business of creating and marketing cartoon characters, is named for Johnny Blastoff, a fictional, animated, cartoon character conceived by Rigsby. Rigsby has developed several other characters in conjunction with the Johnny Blastoff cartoon concept. Blastoff cartoon story lines are set in Tower City, [3]a fictional city that is home to a number of fictional sports teams including the Tower City Rams. Rigsby designed logos for each of the fictional teams.

The NFL is an unincorporated association of member clubs which field professional football teams. The member clubs derive substantial income from admission fees and personal seat licenses, national television and radio broadcast rights, and the sales of jerseys, jackets, and other sports merchandise and memorabilia. Each member club has adopted a team name, as well as symbols, logos, colors, and other identifying marks. Each club's marks have been assigned to the defendant NFL Properties, which licenses other entities to use the

marks in merchandising and promotional activities. The Rams football team, which is one of the NFL's oldest member clubs, was founded in 1937 as the Cleveland Rams franchise and moved to become the Los Angeles Rams in 1946.

Beginning in December of 1993 and throughout 1994, newspaper articles in the St. Louis area reported the possibility that the Los Angeles Rams would move to St. Louis. By late 1994, a "St. Louis Rams Fan Club" had been formed by a bartender at a St. Louis sports bar. On January 17, 1995, a press conference was organized in the city of St. Louis by Georgia Frontiere, owner of the Los Angeles Rams club, and St. Louis Mayor Freeman Bosley who announced that the Rams club intended to relocate from Los Angeles to St. Louis. The press conference was covered by local and national media, including sports writers who filed reports which resulted in articles in USA Today, the *New York Times,* as well as other news media outlets throughout the country. in fact, in the *New* York Times article, Mayor Freeman Bosley is quoted as saying, "The St. Louis Rams-how sweet it is." The January 18, 1995, edition of the St. *Louis Post-Dispatch* included a sixteen-page pullout section devoted to the Rams football club, the front page of which bore the title "St. Louis Rams." Immediately after the press conference, [4]"personal seat licenses" for Rams football games were made available by the Rams club for sale in the St. Louis area. Licenses, which ranged in price from $250 to $4500, granted holders the right to acquire season tickets for home games in St. Louis at the new domed stadium under construction. By early February of 1995, over 72,000 personal seat

license applications had been received by the Rams organization. Later, newspapers reported that the move would have to be approved by the member clubs of the NFL, and though NFL Commissioner Paul Tagliabue made several public statements expressing some doubt that the move would be approved, NFL owners signed off on and approved the relocation on April 12, 1995. While a number of unlicensed vendors began selling unlicensed merchandise bearing the mark "St. Louis Rams" in January of 1995, officially licensed vendors began using the "St. Louis Rams" mark in a wide variety of merchandise sales in April of 1995. For example, immediately after the owners' vote on April 12, LogoAthletic, a licensee of NFL Properties, shipped officially licensed apparel bearing the "St. Louis Rams" mark to the St. Louis area. On April 26, 1995, NFL Properties filed two trademark applications on behalf of the Rams for the mark "St. Louis Rams."

While the NFL was in the process of approving the Rams' relocation from Los Angeles to St. Louis, on February 22, 1995, Blastoff filed a State of Wisconsin trademark application for the mark "St. Louis Rams." Blastoff received a registration certificate the same day. At the time of the filing, Blastoff claimed that it was unaware of any other entity using the mark "St. Louis Rams." On March 10, 1995, Blastoff filed two federal intent-to-use trademark applications for the mark "St. Louis Rams," accompanied by a ram's head design. Blastoff filed four more federal trademark applications in 1997. In each of the applications, Blastoff stated it was unaware of any other party's right to use the mark in commerce.

[5]Blastoff had extremely limited success selling its "St. Louis Rams" merchandise to the public. In July of 1995, Rigsby sold two T-shirts bearing his "St. Louis Rams" mark. In 1997, Rigsby was arrested for attempting to sell counterfeit "St. Louis Rams" T-shirts outside Camp Randall Stadium in Madison, Wisconsin. On July 1, 1997, the plaintiff's attorney also sold a cigar with a band bearing Blastoff s "St. Louis Rams" mark to a friend at a bar.

The defendants made a number of attempts to protect their "St. Louis Rams" NFL football club mark. In August of 1995, the defendants sent the plaintiff a cease and desist letter concerning its unauthorized use of the "St. Louis Rams" name. The plaintiff responded that its products would not be associated with football or the St. Louis Rams football team. In September of 1997, the defendants sent the plaintiff another cease and desist letter regarding licensing solicitation letters the plaintiff had sent to several major companies in the retailing and entertainment businesses.

On June 18, 1996, the United States Patent and Trademark Office ("PTO") published Blastoffs March 10, 1995, trademark application. In response, the defendants filed a notice of opposition to the trademark application the same day. After conducting discovery concerning the PTO opposition proceeding, Blastoff filed a complaint in the United States District Court for the Western District of Wisconsin. Subsequent to that filing, the second of Blastoff's March 10, 1995, trademark applications was published for opposition,

and the defendants again filed a notice of opposition. The PTO suspended all action on all of the plaintiffs and the defendants' applications pending the outcome of this suit.

On March 12, 1998, the defendants moved for summary judgment, arguing that: (1) the Rams had acquired rights in the mark "St. Louis Rams" prior to Blastoff, (2) Blastoff's alleged rights in the mark were based on false and fraudulent claims; (3) Blastoff's marks were likely to be confused with the Rams' marks; (4) Blastoff's marks dilut- [6]ed the distinctive value of the Rams' trademarks; (5) Blastoff lacked standing to bring unfair competition and false advertising claims, and such claims were without merit; (6) the "Rams" mark is not generic; and (7) the Rams' application to the PTO was based on bona fide use of the "Rams" mark in commerce. Blastoff's response to the motion failed to comply with the court's summary judgment procedures in that Blastoff failed to file a memorandum of law in opposition to the defendants' motion for summary judgment.

On June 24, 1998, the district court granted the defendants' motion for summary judgment ruling, *inter alia,* that: (1) the NFL did not infringe Blastoff's "St. Louis Rams" mark under Wisconsin law; (2) Blastoff infringed the NFL's trademark rights; (3) the NFL did not engage in unfair competition or deceptive advertising; (4) the Rams' federally registered "Rams" mark is not generic; and (5) Blastoff is not entitled to money damages. In addition, the court ordered that Blastoff's Wisconsin registration of the "St. Louis Rams" mark be canceled forthwith.

II. ISSUES

-On appeal, we consider: (1) whether the district court erred in concluding that the NFL defendants had acquired protectable rights in the mark "St. Louis Rams" prior to Blastoff-, (2) whether the district court erred in finding a likelihood of cõnfusion exists between the plaintiff's and the defendants' use of the "St. Louis, Rams" mark; (3) whether the district court's ruling that Blastoff failed to raise a genuine issue of material fact concerning the shipment of merchandise bearing the "St. Louis Rams" mark on April 12, 1995, was proper; (4) whether the district court's ruling that Blastoff failed to raise a genuine issue of material fact in support of its claim that the "Rams" mark was generic was proper; (5) whether the district court erred in dismissing the plaintiff's unfair competition and deceptive advertising claims due to the plaintiff's lack [7]of standing; and (6) whether the trial judge's determination that she lacked statutory authority to order the PTO to reject applications for the "St. Louis Rams" mark was proper.

III. DISCUSSION

This Court reviews a district court's grant of summary judgment *de novo. See Green v. Shalala,* 51 F.3d 96, 99 (7th Cir. 1995). Summary judgment is appropriate when there is no genuine issue of material fact and the moving party is entitled to judgment as a matter of law. *See id.* This Court views the record and all reasonable inferences drawn from it in the light most favorable to the nonmoving party. *See Hartford Accident & Indem. v. Chicago Hous. Auth.,* 12 F.3d 92, 95 (7th Cir. 1993).

A. Prior Protectable Rights

Initially, the plaintiff contends that the district court erred in concluding that the NFL defendants had acquired protectable rights in the mark "St. Louis Rams" prior to Blastoff. In response, the defendants argue that they established prior and superior rights in the "St. Louis Rams" mark through the public use of the mark, third-party promotion and advertising, and the fact that the public associated the mark with the Rams NFL franchise. The trial court, reflecting the defendants' view, stated that "by the time plaintiff filed its Wisconsin registration in February 1995, a substantial portion of the public associated the mark 'St. Louis Rams' with defendants' football club."

The determination of whether a party has established protectable rights in a trademark is made on a case by case basis, considering the totality of the circumstances. *See New West Corp. v. ATM Co. of Cal., Inc.,* 595 F.2d 1194, 1200 (9th Cir. 1979). A party may acquire a protectable right in a trademark only through use of the mark [8]in connection with its product. *See Zazu Designs v. L'Oreal, S.A.,* 979 F.2d 499, 503 (7th Cir., 1992). The party seeking to establish appropriation of a trademark must show first, adoption, and second, "use in a way sufficiently public to identify or distinguish the marked goods in an appropriate segment of the public mind as those of [the adopter of the mark]." *New West,* 595 F.2d at 1200. The party who first appropriates the mark through use, and for whom the mark serves as a designation of source, acquires superior rights to it. *See*

Zazu, 979 F.2d at 503-04. Evidence of actual sales is not necessary to establish ownership. *See New West,* 595 F.2d at 1200. Furthermore, current case law in the area of franchise relocation and expansion has created a strong presumption of franchise owner priority in their marks. In *Indianapolis Colts, Inc. v. Metropolitan Baltimore Football Club Ltd.,* 34 F.3d 410, 413 (7th Cir. 1994), this Court held that the "Indianapolis Colts" mark may be viewed simply as "Colts," independent of urban affiliation. While courts consistently define "use" as the public sale of a product, in some circumstances parties have been found to possess rights in an alteration of an existing mark that was used solely by third parties to designate its product. *See Coca-Cola Co. v. Busch,* 44 F.Supp. 405, 409-10 (D. Pa. 1942) ("Coke" protectable trademark for "Coca-Cola"). In addition, advertising and promotion surrounding the development of sports facilities have been found to establish rights in the mark. *See Maryland Stadium Authority v. Becher,* 806 F.Supp. 1236 (D. Md. 1992).

On January 17, 1995, Georgia Frontiere, the owner of the Rams, and St. Louis Mayor Freeman Bosley held a press conference at which they announced the Rams' intention to relocate from Los Angeles to St. Louis. The press conference story received extensive national and local press, including the *St. Louis Dispatch's* publication, on January 18, 1995, of a sixteen-page pullout section of the newspaper entitled "St. Louis Rams." Vendors sold unlicensed "St. Louis Rams" merchandise in the St. Louis [9]area in January of 1995, and by February of 1995, more than 72,000 personal seat licenses for the St. Louis Rams' home games had been

received. By the time Blastoff registered the "St. Louis Rams" mark in Wisconsin in February of 1995, a significant portion of the public associated the mark with the Rams football club. However, Blastoff asserts that the defendants had not sufficiently used the mark "St. Louis Rams" to be given priority. Blastoff argues that at the January 17, 1995, press conference, none of the defendants used the words "St. Louis Rams," and thus, this term was rendered an "unarticulated idea for a team name," which is not protectable. Blastoff also states that newspaper and media coverage is insufficient to establish priority. Finally, Blastoff contends that the football club "operated publicly and exclusively as [the] 'L.A. Rams'" as late as February 8, 1995.

For the purpose of establishing public identification of a mark with a product or service, the fact-finder may rely on the use of the mark in "advertising brochures, catalogs, newspaper ads, and articles in newspapers and trade publications," T.A.B. *Systems v. Pactel Teletrac,* 77 F.3d 1372, 1375 (Fed. Cir. 1996), as well as in media outlets such as television and radio. *See In re Owens-Corning Fiberglas Corp.,* 774 F.2d 1116, 1125 (Fed. Cir. 1985). In addition, courts have recognized that "abbreviations and nicknames of trademarks or names used *only* by the public give rise to protectable rights in the owners of the trade name or mark which the public modified." *Natl Cable Television Assoc. v. Am. Cinema Editors, Inc.,* 937 F.2d 1572, 1577 (Fed. Cir. 1991). Such public use of a mark is deemed to be on behalf of the mark's owners. *See id.* Blastoff has failed to demonstrate any equivalent use of the mark "St. Louis Rams" by February of 1995, when the defendants

established, by use and public association, their priority in the mark. Blastoff's insignificant and very limited use of the mark prior to February of 1995, consisting of the development of the "Tower City Rams" design, along with [10]production of a swatch of material with "St. Louis Rams" embroidery, is insufficient to establish a link between the mark and its products. Furthermore, the owner's use of a trademark is relevant in establishing public identification of a mark with a product or service. Georgia Frontiere, owner of the Rams, in announcing her intention to move the franchise to St. Louis from Los Angeles, implicitly adopted the exact phrase "St. Louis Rams" on the date of her press conference. This Court's decision in. *Indianapolis Colts* is strong support for the proposition that the Rams organization and the NFL had a long established priority over the use of the "Rams" name in connection with the same professional football team, regardless of urban affiliation. Similar to the case under consideration, in *Indianapolis Colts, 34* F.3d at 413, we held that the team's move from Baltimore to Indianapolis

> neither broke the continuity of the team in its different locations - it was the same team, merely having a different home base and therefore a different geo- graphical component in its name-nor entitled a third party to pick (the name] up and use it to confuse Colts fans .... When [the owner] transported his team, the Baltimore Colts, from Baltimore to Indianapolis in one night in 1984, the team remained, for a time anyway, completely intact: same players, same coaches, same front-office personnel.

Similarly, Blastoff's filing of federal trademark applications in March of 1995 fell short of establishing his priority in the marks, even though the Rams in fact did not file their trademark application until April of 1995, as a trademark application is always subject to previously established common law trademark rights of another party. *See The Money* Store v. *Harriscorp Fin., Inc., 689* F.2d *666, 672* (7th Cir. 1982) (quoting McCarthy, *Trademarks and Unfair* Competition § 19:2, at 656). Furthermore, because a product or-organization may be designated by more than one trademark, *see Old Dutch Foods, Inc. v. Dan Dee* Pretzel & Potato Chip Co., 477 F.2d 150, 154 (6th [11]Cir. 1973), it is irrelevant, as the plaintiff suggests, that the official name of the Rams remained "Los Angeles Rams" until April of 1995. Thus, we agree with the district court's determination that the defendants-appellees had acquired protectable rights in the "St. Louis Rams" mark prior to Blastoff.

B. Likelihood of Confusion

The plaintiff next contends that the district court erred in finding a likelihood that confusion exists between Blastoff's and the defendants' use of the "St. Louis Rams" mark. Blastoff's rationale for raising this issue is unclear from its brief, but it seems Blastoff wishes to challenge the district court's determination that Blastoff is not entitled to a declaration that it did not infringe on the Rams' mark. Although the defendants did not assert an infringement counterclaim at trial, the defendants respond by contending that the plaintiff's past and

proposed future use of the "St. Louis Rams" mark infringes upon their common law rights in the mark.

Infringement of unregistered marks is actionable under the Lanham Act, 15 U.S.C. § 1125(a), which provides:

> (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination hereof, or any false designation of any origin, false or misleading description of fact, or false or misleading representation of fact, which--
>
> (A) is likely to cause confusion, or to cause mistake or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
>
> (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or [12]geographic origin of his or her or another person's goods, services, or commercial activities,
>
> shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

Such a claim requires a showing that: (1) the defendants have a protectable trademark; and (2) a

"likelihood of confusion" will exist as to the origin of the plaintiffs products. *International Kennel Club of Chicago, Inc. v. Mighty Star, Inc., 846* F.2d 1079, *1084* (7th Cir. *1988).*

"Whether or not there is a likelihood of confusion is a question of fact as to the probable or actual actions and reactions of prospective purchasers of the goods or services of the parties." Id. at 1087. The district court's determination on this issue amounts to a finding that, even resolving all of the factual disputes referred to in the record in favor of Blastoff, a likelihood of confusion would still exist as a matter of law. *See Hartford Accident & Indem., 12* F.3d at 95. This Court reviews this legal conclusion *de novo. See Sands, Taylor & Wood Co. v. Quaker Oats* Co., 978 F.2d 947, 952 (7th Cir. 1992). In determining whether a likelihood of confusion exists, this Court considers seven factors, weighing their relative importance on a case-by-case basis. *See id.* at 959. These factors are: (1) similarity between the marks in appearance and suggestion; (2) similarity of the products; (3) area and manner of concurrent use; (4) degree of care likely to be exercised by consumers; (5) strength of the complainant's mark; (6) actual confusion; and (7) intent of the infringing party to "palm off" his product as that of the other party. *See Rust Env't & Infrastructure, Inc. v. Teunissen,* 131 F.3d 1210, 1216 (7th Cir. 1997).

In the trial court, the plaintiff Blastoff did not contest that a likelihood of confusion existed, asserting that it believed the public associated the plaintiffs apparel and sundries with the Rams football club. On appeal,

Blastoff changes its focus and now blames the defendants for hav- [13]ing caused a likelihood of confusion to exist. Initially we note that

> [t]his Court has repeatedly held that "the appellant's waiver of [an] argument through his failure to raise a timely objection . . . makes it unnecessary for [the reviewing court] to decide [the issue]." *United States v. Pryor,* 957 F.2d 478, 481 (7th Cir. 1992). Such an objection must "alert ( ] the court and opposing party to the specific grounds for the objection." *United States v. Wynn,* 845 F.2d 1439, 1442 (7th Cir. 1988) (citations omitted).

United States v. Krankel, 164 F.3d 1046, 1052 (7th Cir. 1998). Because Blastoff failed to assert that the defendants caused confusion at trial,* our review is for plain error. *See id.*

> The "keystone" of trademark infringement is "likelihood of confusion" as to source, affiliation, connection or sponsorship of goods or services among the relevant class of customers and potential customers. Usually, the confusion alleged is "forward confusion," which occurs "when customers mistakenly think that the junior user's goods or services are from the same source as or are connected with the senior user's goods or services." In such a case, the junior user attempts to capitalize on the senior' user's good will and established reputation by suggesting that his product comes from the same source as does the senior user's product. Big *0 Tire Dealers v.*

Goodyear Tire & Rubber Co., 561 F.2d 1365 (10th Cir. 1977). In this case, however, [the plaintiff] relies not on classic forward confusion but on the doctrine of "reverse confusion." Reverse confusion occurs when a large junior user saturates the market with a trademark similar or identical to that of a smaller, senior user. In such a case, the junior user does not seek to profit from the good will associated with the senior user's mark. Nonetheless, the senior user is injured because [14]

> [t]he public comes to assume that the senior user's products are really the junior user's or that the former has become somehow connected to the latter. The result is that the senior user loses the value of the trademark-its product identity, corporate identity, control over its goodwill and reputation, and ability to move into new markets.

Ameritech, Inc. v. American Information Technologies Corp., 811 F.2d 960, 964 (6th Cir. 1987); *see also Banff,* Ltd., 841 F.2d at 490-91; *Big O Tire Dealers,* 561 F.2d at 1372.

Sands, Taylor & Wood, 978, F.2d at 957 (citations omitted). In asserting that the defendants are the cause of confusion of the marks, the plaintiff seems to be framing the issue as one of reverse confusion. Thus, the plaintiff argues that the large junior user, the NFL, is saturating the market with a trademark similar or identical to that of the smaller, senior user, Blastoff. *See id. This* argument falls short because, as set forth above, Blastoff is not the senior user and furthermore has no protectable

rights to the "St. Louis Rams" mark. Blastoffs own statement, that the public associated the plaintiffs apparel and sundries with the St. Louis Rams football club, compels the conclusion that the district court did not err in finding that a likelihood of confusion of the parties' marks exists.

C. Shipment of Merchandise

The plaintiff next argues that the trial court erred in ruling that Blastoff failed to raise a genuine issue of material fact concerning the shipment of LogoAthletic merchandise bearing the Rams' "St. Louis Rams" mark on April 12, 1995. Blastoff seems to contend that because the defendants were unable to produce an actual specimen of apparel bearing the "St. Louis Rams" mark which was shipped to the St. Louis area on April 12, 1995, the trial court should have ruled that the defendants produced no [15]evidence of their use of the mark in commerce by that date. The plaintiff argues that the failure to produce the actual shirt "gives rise to an inference adverse to the party failing to produce the original." The trial judge rejected the plaintiffs argument, determining that Blastoff failed to establish a genuine issue of material fact as to the propriety of the shipment date because the defendants had submitted evidence of such use including affidavits, testimony, and a photograph of the shirt.

The defendants submitted a federal application for the "St. Louis Rams" mark on April 26, 1995. The application stated that the defendants' first use of the mark in commerce was on April 12, 1995, the date on which

LogoAthletic, an official NFL licensee, shipped apparel bearing the "St. Louis Rams" mark to the St. Louis area. Accompanying the application was a photograph of a shirt bearing the word mark "St. Louis Rams." The defendants have provided additional support for the claims made on the applications by way of the affidavit testimony of James P. Connely, who served as Senior Vice President of Consumer Products for National Football League Properties in 1995. Connely stated that he had personal knowledge of the shipment, and his testimony corroborates the defendants' contention that the merchandise was shipped on April 12, 1995. The plaintiff's only "support" for its conclusion that the defendants' evidence is insufficient to establish the defendants' use in commerce is a citation to the PTO's Trademark Manual of Examining Procedure § 905.03, which outlines procedures for the PTO's disposal of bulky specimens received with trademark applications. The plaintiff's "support" for its contention is irrelevant to the issue under consideration, and contrary to the plaintiff's claim, the defendants have proffered several exhibits establishing their use of the mark in commerce. Thus, we are in agreement with the district court's ruling that the plaintiff failed to raise a genuine issue of material fact as to this question.

[16]

D. Generic Marks

The plaintiff also contends that the district court erroneously ruled that Blastoff failed to raise a genuine issue of material fact in support of its claim that the "Rams" mark was generic. Specifically, Blastoff claims that because the Colorado State Rams college football

team uses the team name "Rams," the mark has become generic and the defendants have lost their rights in the mark. In making the claim that the "Rams" mark is generic, Blastoff relies on 15 U.S.C. § 1064(3), which provides that a federal trademark registration that has been on the registry for more than five years can be canceled in circumstances where the mark has become "the generic name for the goods or services, or a portion thereof, for which it is registered." The district court found Blastoffs argument on this point "laughably deficient," ruling that the plaintiff failed to produce "any facts supporting its challenge to [the] registration."

A term may be considered generic if it "is one that is commonly used to name or designate a kind of goods," *Mil-Mar Shoe Co. v. Shonac Corp., 75* F.3d *1153, 1157* (7th Cir. *1996),* or it represents the common linguistic usage for such goods. *See Gimix, Inc. v. JS & A Group, Inc., 699 F.2d 901, 905* (7th Cir. *1983).* The defendants' mark registration specifies that the "Rams" name is to be used for "entertainment services-namely, professional football exhibitions." Thus, the product denoted by the "Rams" registration is a professional football team, and the record is devoid of any evidence demonstrating that any other professional football team is known as the "Rams," with the exception of the now extinct "Los Angeles Rams" franchise. The plaintiff has also failed to adduce any evidence that the "Rams" mark has become a common term for professional football teams generally. *See Henri's Food Prods. Co. v. Tasty Snacks, Inc., 817* F.2d *1303, 1305 (7th Cir. 1987).* Contrary to the plaintiff's claim, use of the "Rams" mark by one, or even several, college athletic teams does not establish a

genuine issue as to the mark having become generic as it is [17]defined by the statute because none of the collegiate parties using the mark produces the same product: a professional football team. Furthermore, the record fails to demonstrate that "Rams" is the common linguistic term for a professional football team. *See Gimix,* 699 F.2d at 905.

E. Unfair Competition and Deceptive Advertising

The plaintiff also contends that the district court erred in dismissing its unfair competition and deceptive advertising claims due to the plaintiff's lack of standing. Specifically, the plaintiff contends that in seeking to prevent Blastoff from using the "St. Louis Rams" mark, the defendants marketed football paraphernalia with notices attached which stated that the "Rams" mark was registered with the PTO, and this somehow amounted to deceptive advertising.

In determining that Blastoff lacked standing, the district court ruled that under section 43(a) of the Lanham Act, 15 U.S.C. § 1125, which governs unfair competition and false advertising claims, a party must demonstrate that it "has a reasonable interest to be protected against conduct violating the Act." *Dovenmuehle v. Gilldorn Mortgage Midwest Corp.,* 871 F.2d 697, 700 (7th Cir. 1989). A party bringing suit must assert "a discernable competitive injury." *L.S. Heath & Son, Inc. v. AT&T Info. Sys. Inc.,* 9 F.3d 561, 575 (7th Cir. 1993).

In our consideration of prior protectable rights, we determined that the NFL has established superior rights

to the "St. Louis Rams" mark. As such, under the common law, Blastoff, which has never been part of the NFL in any manner, shape, or form, is precluded from using the "St. Louis Rams" mark, and Blastoff therefore has neither a reasonable interest in a right to be protected by bringing suit, *see Dovenmuehle,* 871 F.2d at 700, nor can Blastoff assert a discernable competitive injury in a right. *See L.S. Heath & Son,* 9 F.3d at 575. Therefore, we agree with the district court's determination that Blastoff lacked [18]standing to bring suit under section 43(a) of the Lanham Act.

F. Authority Over the PTO

The plaintiff also contends that the trial court erred in determining that it lacked statutory authority to order the PTO to reject applications for the "St. Louis Rams" mark. At trial, each party requested that the district court order the PTO to reject the other party's "St. Louis Rams" application. The defendants argued that 15 U.S.C. § 1119 provides the trial court with the necessary power to do so. Section 1119 provides that "[i]n any action involving a registered mark the court may determine the right . . . to the registrations of any party to the action."

On appeal, the defendants now contend that the trial court properly determined that it lacked statutory authority. On the other hand, Blastoff seems to challenge the trial court's determination that it lacked statutory authority to order the PTO, but provides no factual or legal support. Federal Rule of Appellate Procedure 28(a)(9)(A) provides that all arguments on appeal must

be supported by "citations to the authorities and parts of the record on which the appellant relies." This Court has previously refused to consider unsupported or cursory arguments, *see United States v. Berkowitz, 927* F.2d 1376, 1384 (7th Cir. 1991), and we refuse to make any exceptions in this case. Because the plaintiff has failed to adequately challenge this issue on appeal, we need not reach a conclusion concerning the trial court's authority to order the PTO to reject trademark applications.

G. Miscellaneous Contentions

Finally, Blastoff raises a number of unconventional responses to the defendants' motion for summary judgment and to the district court's ruling. Blastoff contends that, despite not following the written procedures of the West- [19]ern District of Wisconsin regarding motions for summary judgment, the district court abused its discretion in denying both Blastoff's Motion for Leave to File Opposition to Summary Judgment in Format as Filed Herewith and its Motion for Leave to File a Surreply and Statement of Supplemental Authorities.

This Court, along with the other twelve circuits, has in the past recognized and will continue to recognize the importance of enforcing its procedural rules for filing and responding to motions for summary judgment; if we did not, we would essentially be left with a court in chaos. An entry of summary judgment will be sustained "where the nonmovant has failed to submit a factual statement *in the form called for by the pertinent rule* and thereby conceded the movant's version of the facts," if

on the basis of the factual record the movant is entitled to judgment as a matter of law. *Brasic v. Heinemann's Inc., 121* F.3d 281, 286 (7th Cir. 1997) (emphasis added). Blastoff's attorney was and should have been aware of both the local rules and the district court's intention to uphold them. The district court did not abuse its discretion in denying the motions.

Similarly, Blastoff's contention that the district court erred in denying its Motion for Reconsideration, Amendment, or Vacatur of its June 24 opinion is without merit. A motion for reconsideration "allows a party to direct the district court's attention to newly discovered material evidence or a manifest error of law or fact." *Moro v. Shell* Oil Co., 91 F.3d 872, 876 (7th Cir. 1996). The motion for reconsideration is not an opportunity for a party to correct its own procedural failures or introduce evidence that should have been brought to the attention of the court prior to judgment. *See id.* Blastoff has failed to demonstrate that the district court's opinion is inadequate or erroneous, and thus, the district court did not abuse its discretion in denying the motion.

The final issue on appeal concerns Blastoff's perception that the district court failed to consider Blastoff's evidence [20] in rendering its opinion. This argument will not be addressed substantively, as Blastoff did not even attempt to support its contention with argument in its brief *See Berkowitz, 927* F.2d at 1384.

IV. CONCLUSION

The district court did not commit error in granting the defendants' summary judgment motion.

AFFIRMED.

A true Copy:

Teste:

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Clerk of the United States Court of Appeals for the Seventh Circuit

IN THE UNITED STATES DISTRICT COURT

FOR THE WESTERN DISTRICT OF WISCONSIN

JOHNNY BLASTOFF, INC., OPINION AND ORDER

Plaintiff,

97-C-155-C

V.

LOS ANGELES RAMS FOOTBALL COMPANY, ST. LOUIS RAMS PARTNERSHIP, NATIONAL FOOTBALL LEAGUE PROPERTIES, INC., and NATIONAL FOOTBALL LEAGUE,

Defendants,

V.

RODNEY RIGSBY,

Counterclaim Defendant.

Plaintiff and defendants each claim exclusive rights for the use of the mark "St. Louis Rams." Defendants' asserted rights to the mark stem from their status as owners, operators and assignees of the professional football team that has gone by that name since its 1995 move to St. Louis, Missouri from Los Angeles, California, Plaintiff claims to have developed its own "St. Louis Rams" mark in conjunction with a fictional cartoon storyline (which is as [2]yet unpublished and unproduced) and to have filed federal intent-to-use

trademark applications for the mark before defendants' approved the relocation of the Rams football team to St. Louis and applied for federal registration of the mark. Defendants initiated an opposition proceeding in the Patent and Trademark Office, challenging plaintiffs applications for registration. Before the PTO could rule in that proceeding, plaintiff filed this action seeking numerous declaratory judgments concerning the parties' competing claims to and right to registration of the "St. Louis Rams" mark. Plaintiffs complaint included a state law infringement claim against defendant, a declaratory claim of plaintiffs noninfringement under federal law, a claim of unfair competition against defendant under federal and state law, a challenge to defendants' separate federal registration on the mark "Rams" and a claim for monetary damages under Wisconsin's unfair trade practices statute. Defendants have counterclaimed, seeking orders directing the PTO to reject plaintiffs federal applications for the "St. Louis Rams" mark and the Wisconsin Secretary of State to cancel plaintiffs state registration in that mark as well as an award of attorney fees.

Now before the court is defendants' motion for summary judgment on all claims, which will be, granted in most respects. The undisputed facts show that defendants obtained protectible rights in the "St. Louis Rams" mark before plaintiff received its state registration, filed its first federal applications or actually used the mark in commerce. Defendants' priority of rights in the mark requires cancellation of plaintiff's state registration and dooms [3]plaintiffs state law claim of infringement brought on the basis on that registration. Additionally,

defendants' priority in the mark ends plaintiffs quest for a declaration of noninfringement because plaintiff has conceded a likelihood of confusion between the parties' marks. Plaintiffs unfair competition and deceptive advertising claim, in which it challenges defendants' efforts to protect their interest in the "St. Louis Rams" mark, fails because plaintiff can show no injury from the conduct, having never had an interest in the mark superior to defendants'. Finally, plaintiffs claim seeking cancellation of defendants' "Rams" registration fails because plaintiff has produced no evidence demonstrating that the mark is generic.

Because the PTO has yet to rule on the parties' competing federal applications for registration of the "St. Louis Rams" mark, this court is without authority to direct that body to grant or deny the pending applications. Such decisions are to be made in the first instance by the Trademark Trials and Appeals Board of the PTO and appealed to a federal district court if an aggrieved party so chooses. It is premature at this point to grant the relief sought by the parties. Accordingly, the claims for declaratory and injunctive relief regarding the registerability of the parties' applied-for marks will be denied. Finally, defendant's claim for attorney fees under the inherent powers of this court and 15 U.S.C. § 1117(a) will be denied because plaintiffs complaint and litigation conduct, although questionable at times, does not warrant fee shifting. [4]This district requires that specific procedures be followed by lawyers filing documents in support of or opposition to motions for summary judgment Although copies of the procedures were distributed with the court's August 28, 1997 pretrial

conference order, counsel have ignored them in numerous respects. In opposing defendants' motion for summary judgment, plaintiff has submitted no response brief (as required by Procedure III(D)) and has filed a document of additional proposed findings of fact and conclusions of law that include numerous numbered paragraphs mixing factual and legal assertions (see Procedures III(B)(4) and III(C)(2), which provide for additional proposed facts and additional conclusions of law as separate submissions). Additionally, many of plaintiffs factual submissions either include citations to portions of the record that do not support the asserted fact or include no comprehensible citation at all. Finally, plaintiffs objection to defendants' proposed facts include several discovery gripes that are untimely and inappropriately raised here. For their part, defendants have made several factual assertions that rely on evidentiary support not found in the court's record, including numerous citations to deposition exhibits that were never submitted. Additionally, defendants oppose several of plaintiffs factual assertions with general denials not accompanied by evidentiary support.

All factual submissions unsupported by proper citation to the record will be disregarded for purposes of deciding this motion for summary judgment. See Procedure [5] I(B)(3) and (4). Although plaintiffs failure to file a responsive brief is not fatal, it serves as a general forfeiture of plaintiffs opportunity to elaborate on the legal theories presented in its complaint. See Johnson v. Gudmundsson, 35 F.3d 1104, 1112 (7th Cir. 1994). Plaintiff has interspersed certain legal arguments throughout its response to defendants' proposed findings

of fact and conclusions of law and in its own proposed findings and conclusions and I have undertaken some effort to extract these legal assertions and formulate an understanding of plaintiffs arguments. However, in deciding a motion for summary judgment, "just as a district court is not required to 'scour the record looking for factual disputes,' it is not required to scour the party's various submissions to piece together appropriate arguments." Little v. Cox's Supermarkets, 71 F.3d 637, 641 (7th Cir. 1995) (citations omitted).

On June 22, 1998, plaintiff filed a motion for leave to File a supplemental affidavit in opposition to defendants' motion for summary judgment. Because the affidavit is so tardy and because the subject of the affidavit has only the most tangential bearing on the decision, leave to file the supplemental affidavit will be denied.

From the properly supported submissions of the parties, I find that the following facts are not in dispute. [6]

UNDISPUTED FACTS

Plaintiff Johnny Blastoff, Inc. is a corporation organized under the laws of Wisconsin. Counterclaim defendant Rodney Rigsby is President and Chairman of the Board of plaintiff Johnny Blastoff and its primary shareholder. Unless otherwise specified, the term "plaintiff" will refer to both Johnny Blastoff the corporation and Rodney Rigsby the individual. Defendant The Rams Football Company, formerly named the Los Angeles Rams Football Company, is a corporation organized under Delaware law with its offices in St. Louis, Missouri.

Defendant St. Louis Rams Partnership is jointly owned by defendant The Rams Football Company and ITB Football Company (not a named party to this action) and has its offices in St. Louis. Defendant National Football League, which has its offices in New York City, is an unincorporated association of numerous member clubs. Defendant National Football League Properties, Inc. is a California corporation with offices in New York.

A. Defendants' Background

The member clubs of defendant National Football League field professional football teams throughout the United States. The football games between these teams are hugely popular events. Each member club derives substantial income through admission fees and broadcast rights for the games, which are televised nationally. To identify and distinguish their respective teams, the member clubs have adopted various team names, symbols, logos, [7]colors and other identifying marks. These marks have been assigned exclusively to defendant National Football League Properties, which is jointly owned by all of the member clubs. Defendant National Football League Properties is responsible for filing and maintaining trademark applications and registrations for these marks on behalf of the member clubs and for protecting the marks from improper use. Additionally, defendant National Football League Properties licenses other entities to use the marks of the member clubs in connection with a wide variety of merchandise and promotional activities.

One of defendant National Football League's member clubs fields a professional football team known currently as the St. Louis Rams. That team was formed in 1936 as the Cleveland Rams and joined the defendant National Football League in 193 7. In 1946, the Rams club relocated to Los Angeles, where it played as the Los Angeles Rams through 1994. At a press conference on January 17, 1995, then owner of the Rams club Georgia Frontiere announced the club's intention to relocate to St. Louis, The relocation was rejected initially by the defendant National Football League, but was approved on April 12, 1995. The club started playing as the St. Louis Rams in the fall 1995 football season and hosted its home games at Busch Stadium and, as of November 1995, at the newly completed Trans World Dome, both located in St. Louis.

The Rams club owns the following federal trademark registrations, which predate the 1995 move to St. Louis: No. 971,048 for the mark "Rams"; Nos. 971,047 and 1,889,818 [8]for the mark "Los Angeles Rams"; No. 971,046 for a distinctive ram's head design mark; Nos. 969,844 and 1,861,767 for a distinctive helmet logo depicting a stylized yellow ram's horn design on a blue football helmet; Nos. 1,217,887 and 1,228,986 for blue and yellow home and away uniform designs; and No. 1,677,080 for a stylized "LA Rams" mark. Registration No. 971,048 for the mark "Rams," was issued in 1973 for "entertainment services--namely, professional football exhibitions" in International Class 41. The Rams club has used these marks continuously for a number of years in connection with its business of promoting the Rams professional football franchise. The marks are

recognized by the public and associated with the Rams National Football League team.

B. Rams' Relocation to St. Louis

Beginning in December 1993 and throughout 1994, newspaper articles in the St. Louis area reported the possibility that the Los Angeles Rams would move to St. Louis. By late 1994, a "St. Louis Rams Fan Club" had been formed by a bartender at a local sports bar. On January 17, 1995, a press conference was held in St. Louis by Georgia Frontiere and St. Louis Mayor Freeman Bosley, among others, at which it was announced that the Rams club intended to move to St. Louis. The press conference was covered by local and national media, leading to January 18, 1995 articles on the front sports page of USA Today and in the sports section of the New York Times. In the New York Times article, Mayor Bosley is [9]quoted as having said "[t]he St. Louis Rams-how sweet it is." The January 18, 1995 edition of the St. Louis Post-Dispatch included a special 16-page pullout section devoted to the Rams club, the front page of which bore the title "St. Louis Rams" accompanied by illustrations of the Rams helmet design mark.

Shortly after the January 17 press conference, newspapers reported that the Ram's move would have to be approved by the member clubs of defendant National Football League. Paul-Tagliabue, commissioner of defendant National Football League, made several public statements regarding the considerations the league would take into account and expressing some doubt that

the move would be approved. On March 8 and 9, 1995, Tagliabue stated publicly that he opposed the move. On March 15, 1995, the member club owners met and voted against the proposed relocation of the Rams. Although the Rams organization remained committed to relocating to St. Louis, at one point after the March 15 rejection a club official speculated publicly that the Rams might end up playing the fall 1995 season back in their old home. However, on April 12, 1995, the member club owners met again and approved the Ram's relocation to St. Louis. This approval was reported widely by the national media.

When a member club of defendant National Football League announces plans to relocate, demand for merchandise bearing the trademarks and indicia of that club increases. However, on January 17, 1995, an executive of defendant National Football League [10]Properties informed all licensees by letter that they were prohibited from manufacturing or selling merchandise bearing the mark "St. Louis Rams" until the team's move was approved by defendant National Football League. Licensees were permitted to sell merchandise bearing the words "St. Louis Football" or "Rams." Several vendors sold unlicenced merchandise bearing the mark "St. Louis Rams" in St. Louis in January 1995. Outside counsel for defendant National Football League Properties sent cease and desist letters to several of these vendors.

Immediately after the January 17 relocation announcement, "personal seat licenses" for Rams football games were made available for sale in the St.

Louis area. A license granted its owner the right to acquire season tickets for Rams home games in St. Louis at the domed stadium then under construction. The licenses ranged in price from $250 to $4,500, depending on the seat. Applications for purchase were printed in the St. Louis Post Dispatch and available at stores and banks throughout the St. Louis area. The applications and brochures referred to the club as the "Rams" and included the ram helmet design mark but did not use the title "St. Louis Rams." By early February 1995, over 72,000 personal seat license applications had been received.

On April 12, 1995, the day the defendant National Football League approved the Ram's relocation to St. Louis, LogoAthletic, a licensee of defendant National Football League Properties, shipped officially licensed apparel bearing the "St. Louis Rams" mark to the St. [11]Louis area. Since April 1995, licensees have used the "St. Louis Rams" mark in connection with a wide variety of team-identified merchandise available to the public, including apparel, toys, sporting goods, novelties, posters, trading cards, glasses and drink bottles. These products are sold in a wide variety of stores and locations and most range in price between five and forty dollars.

On April 26, 1995, defendant National Football League Properties filed two federal trademark applications for the word mark "St. Louis Rams" on behalf of defendant Rams Football Company (known then as the Los Angeles Rams Football Company). Application No. 74/666,081 was a use-based application for "clothing,

namely t-shirts, caps and sweatshirts" based on a first use date of April 12, 1995. Application No. 74/706,358 was an intent-to-use application for additional apparel items in International Class 25 as well as for paper goods and printed materials in International Class 16, various sports equipment in International Class 28 and entertainment services in International Class 41. On May 2, 1995, defendants were issued Missouri Trademark Registration No. 13,221 for the "St. Louis Rams" mark.

C. Plaintiffs Use of Mark

Plaintiff was incorporated in July 1993 and is named for Johnny Blastoff, a fictional animated cartoon character conceived by counterclaim defendant Rigsby. Rigsby has [12]developed several other characters in conjunction with the Johnny Blastoff cartoon concept. The Blastoff storylines are set in Tower City, a fictional city that is home to numerous fictional sports teams. The Tower City Rams is one of those teams. Additionally, plaintiff conceived of several fictional teams from actual cities, such as the Phoenix Scorpions and Orlando Werewolves, who were to serve as the opponents for the Tower City teams. Plaintiff developed logos for several of these fictional teams. By late 1994, plaintiff had created a "Bibliography" describing the characters and general premise of the Johnny Blastoff cartoon. The bibliography mentioned the "Tower City Rams" as one of the sports teams that would appear in the cartoon.

Plaintiffs first use of the mark "St. Louis Rams" on a tangible item was the creation in February 1995 of a swatch of material with the words "St. Louis Rams"

embroidered on it. The lettering on the swatch was yellow with blue trim. At that time, Rigsby was aware that the Rams football club was planning to move to St. Louis. Also in February. plaintiff ordered a professional trademark search of the mark "St. Louis Rams" for use on sports apparel. Before plaintiff received the results of that search, Rigsby executed a State of Wisconsin trademark application for a mark consisting of the words "St. Louis Rams" accompanied by an design of a uniformed football player running with a football. The head of the football player is made of cheese. Plaintiff filed this application with the Wisconsin Secretary of State on February 22, 1995 and received a Wisconsin registration certificate [13]that same day. In the application, plaintiff stated that the date of first use of the mark was October 13, 1993. Plaintiff has never placed this mark on any merchandise. The design portion of the mark was developed in 1993 and shown to merchandise designers on October 13, 1993. The words "St. Louis Rams" were not combined with the design until 1995.

On March 10, 1995, plaintiff filed two federal intent-to-use trademark applications for a mark consisting of the words "St. Louis Rams" and a design depicting a ram's head. Application No. 74/644,300 was for clothing in International Class 25 and specified numerous types of apparel from athletic shoes to overcoats to bow ties. Application No. 74/659,944 in International Class 16 was for "Fictional animated and cartoon sports, namely basketball, baseball, soccer, hockey, and football" and specified its application to depictions in numerous media, including comic books,

video recordings, art prints, gift wrapping paper and trading cards.

Also on March 10, 1995, plaintiff Rigsby placed a telephone call to a department store in St. Louis and discussed his "St. Louis Rams" products with one of the store's buyers. Plaintiff preserved no notes from this conversation. In July 1995, plaintiff sold two t-shirts bearing the "St. Louis Rains" mark: one sale was made by plaintiff Rigsby to a friend of his at her apartment and the other sale was to a St. Louis resident. These are plaintiffs first sales of merchandise bearing the "St. Louis Rams" mark and the only sales of such merchandise by plaintiff in 1995. In June 1997, plaintiff Rigsby attempted to sell "St. Louis [14]Rams" t-shirts outside Camp Randall Stadium in Madison, Wisconsin on the night of a concert. He was arrested on charges of selling "counterfeit" merchandise. On July 1, 1997, plaintiff sold a single cigar with a yellow band bearing the "St. Louis Rams" mark and ram's head design from plaintiffs March 10, 1995 federal application. The sale was made through plaintiffs attorney in this action to an acquaintance of that lawyer and took place in a bar. Beyond these efforts, plaintiff has not sold any merchandise bearing the mark "St. Louis Rams" to a member of the general public or offered such merchandise for sale through advertising, mail order catalogs or retail distribution.

In 1997, plaintiff filed four more federal trademark applications. Application 75/295,056, filed May 20, 1997, was a use-based application for the word mark "St. Louis Rains" for use on t-shirts, hats, sweatshirts and

other clothing or clothing material swatches. The application claimed a first use date of February 22, 1995 and a first use in commerce date of March 10, 1995. Application Nos. 75/304,922, 75/304,923 and 75/304,924 were all filed on June 6, 1997 and were all intent-to-use applications for the "St. Louis Rams" and ram's head design. Each application specified different products on which the mark would be used: the '922 application was for specified beverages in International Class 32; the '923 for alcoholic beverages in International Class 33; and the '924 application for tobacco products and accessories in International Class 34. In each of these applications, as in plaintiffs previous applications, Rigsby signed his name and averred that he was unaware of [15]any other party that had the right to use the mark in commerce.

In September 1997, plaintiff sent solicitation letters offering to license its "St. Louis Rams" mark and designs to several major companies in the entertainment and consumer products business, including Phillip Morris, Reebok, Wait Disney and Wal-Mart. None of the companies that responded to plaintiffs letter indicated interest in licensing plaintiffs mark. Through its entire history, plaintiff Blastoff has not entered into any licensing agreements or received any licensing revenues.

D. Public Perception of Marks

A likelihood *of* confusion exists between plaintiffs and defendants' "St. Louis Rams" marks. People mistake plaintiffs "St. Louis Rams" shirts as being affiliated with

defendants' St. Louis Rams football team. However, several collegiate athletic teams share the nickname of "Rams," including Colorado State University, the University of Rhode Island and Fordham University. The football team from Colorado State wears helmets bearing a design that is similar to defendants' helmet design trademark.

E. Defendants' Efforts to Protect Mark

In August 1995, counsel for defendants sent a cease and desist letter to plaintiff concerning use of the "St. Louis Rains" name. In her response to the cease and desist letter, [16]then counsel for plaintiff stated that plaintiffs products "will not be related to, visually descriptive of, or otherwise associated with football or the devices and colors of the Los Angeles Rams." However, plaintiffs plans include the possibility of fielding a football team named the "St. Louis Rams" and joining a new professional league proposed by the National Broadcasting Corporation (NBC) and Turner Broadcasting. On September 26, 1997, counsel for defendants sent a second cease and desist letter to plaintiff regarding plaintiffs September 1997 licensing solicitation letters.

In September 1995, defendants placed an advertisement in the St. Louis Post Dispatch warning readers to "watch out for fake St. Louis Rams merchandise." The advertisement stated that such merchandise was illegally manufactured and instructed customers to shop at official NFL retailers. Certain products licensed by defendant National Football League Properties contain

one of the following statements on their packaging: "The team name on this product is the registered trademark of the NFL Club depicted on this product"; "Team names, nicknames, logos and other indicia are the trademarks of the teams indicated"; or "Team names and logos are registered trademarks of the team indicated." Other products' packaging contains the following statement: "The names, symbols, emblems, designs, logos, and other indicia of the NFL and its member clubs are registered in the United States Patent and Trademark Office ("PTO") and are protectible against unauthorized use." [17]

F.Procedural History of Federal Trademark Applications

On June 18, 1996, the United States Patent and Trademark Office published plaintiffs March 10, 1995 Application No. 74/644,300 for opposition. That same day, defendants filed a notice of opposition to the application, initiating Opposition Proceeding No. 102,722. After significant discovery was conducted in this matter, plaintiff instituted the present action in this court. Upon motion of defendants, the PTO suspended Opposition Proceeding No. 102,722 pending disposition of this case. On July 22, 1997, plaintiffs second March 10, 1995 federal application, No. 74,659,944, was published for opposition. Defendants filed their notice of opposition to that application, initiating Opposition Proceeding 108,292, and requested suspension of the proceeding pending completion of this action. The PTO suspended the proceeding.

Defendants' federal trademark Applications Nos. 74/666,081 and 74/706,358 have been suspended by the Patent and Trademark Office pending final resolution of plaintiffs earlier-filed applications.

DISPUTED FACTS

In addition to the facts recited above, each side has made additional factual assertions that their opponent has attempted to place in dispute, with varying degrees of success. Because plaintiff is the non-movant, genuine factual disputes must be resolved in its favor. [18]However, the court is required to draw only reasonable inference in support of plaintiffs position; it need not draw every conceivable inference in its favor. See Tyler v. Runyon, 70 F.3d 458, 467 (7th Cir. 1995) (quoting Spring v. Sheboygan Area School Dist., 865 F.2d 883, 886 (7th Cir. 1989)). Further, testimonial evidence "can and should be rejected without a trial if, in the circumstances, no reasonable person would believe it." Seshadri v. Kasraian, 130 F.3d 798, 802 (7th Cir. 1997).

Plaintiff takes issue with defendants' factual assertion that defendants' licensees commercially shipped apparel bearing the "St. Louis Rams" mark on April 12, 1995. Plaintiff challenges the evidence with which defendants support this assertion: the affidavit testimony of James P. Connely, Senior Vice President of Consumer Products for defendant National Football League Properties, and a January 1998 letter from an official at LogoAthletic to an employee of defendant National Football League Properties confirming that a shipment of "St. Louis

Rams" merchandise occurred on that date. The admissibility of this letter is questionable, as defendants have not authenticated the document and have been unable to identify any exception to the rule barring hearsay that would apply. However, the shipment is supported sufficiently by the direct testimony of Connely, who was employed by defendant National Football League Properties throughout 1995 and whose position supports his assertion that he has personal knowledge of the shipment.

Additionally, plaintiff contends that neither defendants nor their licensees could have [19]shipped "St. Louis Rams" apparel on April 12, 1995, the same day the Rams' move was approved. Plaintiff argues that it would have been impossible for anyone to develop a logo, select the proper materials and manufacture the trademark-bearing merchandise all on the same day the move was approved. However, defendant asserts only that the shipment of the apparel, not its creation, occurred on April 12. It is possible, and highly probable, that the licensees designed and manufactured the goods prior to that date in anticipation of the approval vote! Finally, plaintiff cites documents showing that a new logo for defendants" 'St. Louis Rams" football team was not developed and finally approved until June or July of 1995. This fact is irrelevant; no one contends that the merchandise shipped on April 12 bore the new logo, only that it bore the "St. Louis Rams" word mark. Moreover, this subsequently developed logo is completely unrelated to this action, as it does not serve as the basis of plaintiffs infringement claim and is not included in any of the contested trademark applications.

Because plaintiff has not raised a genuine dispute regarding the shipment of merchandise bearing defendants' word mark "St. Louis Rams" on April 12, 1995, that fact is accepted as true for purposes of this motion.

Relying on the same arguments, plaintiff contends that defendants falsified their April 26, 1995 federal use-based application by listing April 12, 1995 as the date of first use and by including a fraudulent photographic specimen of a shirt bearing the "St. Louis Rams" mark. Because defendants have established that the April 12 shipment occurred, plaintiffs [20]challenge to the accuracy of the first-use date fails. Plaintiffs sole additional objection to the specimen is that defendants have been unable to produce the shirt that was the subject of the photograph submitted with the application. Defendants' failure to keep track of this article of clothing for the three years since the application was filed does not support a reasonable inference that the application was fraudulent.

For their part, defendants dispute several of plaintiffs factual assertions that are supported solely by the affidavit testimony of counter-defendant Rigsby. Primarily, these disputes concern the time frame and context in which plaintiff decided to utilize the "St. Louis Rams" mark. Rigsby has asserted that he came up with the name "St. Louis Rams" in 1993 in conjunction with the Johnny Blastoff cartoon and before he was aware of the Los Angeles Rams possible move to St. Louis. However, plaintiff has produced no tangible evidence containing the name "St. Louis Rams" that

predates 1995, despite the fact that plaintiff produced logo and team name illustrations for other Johnny Blastoff sports teams during this time. Additionally, the name "St. Louis Rams" does not appear in plaintiff's late 1994 Johnny Blastoff bibliography.

Similarly, Rigsby contends that he asked artist Evan Schultz to develop the ram's head design in 1993 or 1994. In his deposition, Schultz testified that this occurred later and that he was aware of the Los Angeles Rams' intended move to St. Louis at the time he created the design. Rigsby's claims are drawn into question further by the fact that he did not submit [21]the ram's head design with his February 1995 Wisconsin state registration, but rather coupled the word mark "St. Louis Rams" with a design of a cheese-headed football player, a figure that invokes the sentiments of Wisconsin sports fans. It seems implausible that plaintiff would have had access to a ram's head design in February 1995 but nonetheless registered a "St. Louis Rams" trademark that included a design with no logical connection.

Relying on all these arguments, defendant contends that Rigsby's alleged telephone call in December 1993 to an apparel retailer in Chicago regarding "St. Louis Rams" merchandise is too incredible to be believed. Rigsby kept no notes from the conversation, although he has produced telephone records showing that a call did occur, and the alleged recipient of the call is now deceased.

Although these factual assertions may stretch the bounds of logic, it is unnecessary to determine whether they are

too implausible to be believed by a reasonable jury. Even if plaintiff is presenting an accurate version of its development of the "St. Louis Rams" mark and ram's head design and Rigsby's alleged 1993 phone call, it cannot establish that it obtained rights in the "St. Louis Rams" mark superior to those held by defendants.

OPINION

Throughout this litigation, plaintiffs filings with this court have shifted from the frustratingly vague to the utterly cryptic to the inexplicably absent. In the claim for relief [22]in its second amended complaint, the operative pleading in this matter, plaintiff fails to identify clearly all relief sought or the legal basis for relief. Instead, plaintiff lists a wide range of issues on which it requests declaratory judgment, including several issues that are redundant or unconnected to any stated legal theory. See First Am. Compl., 24-1 to 24-2 From the amended complaint, defendants have culled five distinct declaratory judgment claims advanced by plaintiff. I have identified four additional requests for relief, one for declaratory relief, two for injunctive relief and a claim for monetary damages. By failing to file a brief, plaintiff has forfeited any opportunity to provide its own interpretation or explanation of its claims. See Johnson, 35 F.3d at 1112.

Plaintiffs complaint sets out the following cognizable claims: 1) for declaratory relief holding that defendants infringed plaintiffs "St. Louis Rams" trademark under Wisconsin law; 2) for declaratory relief holding that plaintiff did not infringe any of defendants' federal or

state trademark rights; 3) for declaratory relief holding that plaintiffs federal trademark applications in the "St. Louis Rams" mark are "superior in both time and right" to defendants' federal applications for the same mark; 4) for declaratory relief holding that defendants committed fraud on the United States Patent and Trademark Office in their April 26, 1995 trademark applications for the mark "St. Louis Rams"; 5) for injunctive relief ordering the PTO to reject defendants' trademark applications; 6) for declaratory relief holding that defendants engaged in unfair competition and deceptive advertising under [23]federal and state law in connection with statements concerning the registration status of the St. Louis Rams" mark; 7) for declaratory relief holding that defendants' federal trademark registration for the mark "Rams" is subject to cancellation on the grounds that it is generic; 8) for injunctive relief ordering the PTO to cancel defendants' federal registration for the "Rams" mark; and 9) for monetary relief of at least $ 100,000,000 doubled under Wis. Stat. 100.20(5).

For their part, defendants have filed a counterclaim in which they request injunctive relief 1) ordering the PTO to sustain defendants' opposition to plaintiffs March 10, 1995 federal trademark applications for the mark "St. Louis Rams"; 2) ordering the PTO to refuse registration for plaintiffs remaining four federal trademark applications for the same mark; and 3) ordering the Wisconsin Secretary of State to cancel plaintiffs Wisconsin registration of the mark. Additionally, defendants seek an award of attorney fees under the Lanham Act.

A. Authorization to Order Disposition of Pending Applications

Both parties ask this court to order the Patent and Trademark Office to reject the other's applications for federal trademark registration for marks including the word mark "St. Louis Rams." Because the PTO has not yet reached a decision on any of the challenged applications, this courts statutory authority to order such relief is questionable. It is not available under 15 U.S.C. § 1071, which authorizes federal courts to hear appeals of final [24]PTO rulings on trademark applications, and the Court of Appeals for the Seventh Circuit has held that the appeal provisions of § 1071 provide the sole grounds for federal court "jurisdiction over registration proceedings." See Merrick v. Sham & Dohme, 185 F.2d 713, 717 (7th Cir. 1950) (using "jurisdiction" in the sense of statutory authorization to rule on the registerability of the applied-for marks); see also 5 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 32:53 (4th ed. 1998) ("a registrant whose mark is attacked for cancellation before the Trademark Board[] cannot short-circuit the administrative process by filing suit for declaratory judgment in the federal courts") (citing Merrick, 185 F.2d 713).

Defendants contend that 15 U.S.C. § 1119 provides the necessary authorization. Section 1119 states that "[i]n any action involving a registered mark the court may determine the right to registration, order the cancellation of registrations ... and otherwise rectify the register with respect to the registrations of any party to the action."

Defendants argue that § 1119 applies because this action "involves a registered mark," in that plaintiff seeks cancellation of defendants' federal registration No. 971,048 for the mark "Rams. 11 Therefore this court may determine the "right to registration" of the parties' applied-for marks.

Several cases hold that § 1119 authorizes federal courts to determine the registerability of an as-yet unregistered mark in an action in which a registered mark is [25]involved as well. See Avon Shoe Co. v. David Crystal, Inc., 279 F.2d 607, 614-15 (2d Cir. 1960); Massa v. Jiffy Products Co., 240 F.2d 702, 707(9th Cir. 1957); Guardian Life Insurance Company of America v. American Guardian Life Assurance Co., No. 95-3997 1995 WL 723186,37 U.S.P.Q.2d 1847 (E.D. Pa. Nov. 14, 1995); Continental Connector Corp. v. Continental Specialties Corp., 413 F. Supp. 1347, 1348-49 (D. Conn. 1976). However, the Court of Appeals for the Seventh Circuit has yet to adopt the approach taken in this line of cases or retreat in any way from the position it took in Merrick, 185 F.2d at 717. Even if these cases were controlling, they read § 1119 to allow intrusion into trademark application proceedings only when there is a sufficient nexus between the application proceeding and the dispute involving the registered mark. See Continental Connector, 413 F. Supp. at 1349 ("even under § 1119, a court, exercising jurisdiction over a suit involving a registered mark, would not be expected to entertain unrelated claims for registration of other marks"). The question, then, is whether the registerability issues of the parties' "St. Louis Rams" trademark applications are sufficiently related to

plaintiffs claim for cancellation of defendants' registered "Rams" mark to trigger the authorization mended by § 1119.

In virtually every case in which a federal court has found authorization to determine the initial registerability of a mark under § 1119, that registerability determination was tied directly to a challenge to an existing competing registration or a claim of infringement based [26]on an existing registration. See Avon Shoe Co., 279 F.2d 607 (after claim for infringement of plaintiffs registered mark failed because defendant had right to concurrent use of mark, court ordered PTO to allow defendant concurrent registration); Massa, 240 F.2d 702 (defendant in infringement action sought cancellation of plaintiffs "jiffy" registration and order directing PTO to register defendant's own "jiffy" mark); Guardian Life Insurance, 37 U.S.P.Q.2d 1847 (defendant sought cancellation of plaintiffs service mark registrations for "Guardian," -The Guardian" and similar marks and declaratory judgment that defendant entitled to federal registration of its service mark "American Guardian"). In the present dispute, plaintiffs attempt to cancel defendants' "Rams" registration on the grounds that it is generic has no bearing on the parties' disputes over their competing applications for the "St. Louis Rams" marks. Defendants do not rely on the existing "Rams" registration in their opposition to plaintiffs attempt to register its "St. Louis Rams" mark and plaintiff does not contend that the alleged generic nature of the "Rams" registered mark hinders defendants' efforts to obtain registration for "St. Louis Rams." The claim involving defendants' registered mark and the claims seeking a determination of

registerability of the applied for marks involve entirely distinct legal and factual determinations: the former turns on whether the mark "Rams" has become generic, see 15 U.S.C. § 1064(3), and the latter depend on which party has legal priority in the mark "St. Louis Rams," see 15 U.S.C. § 1052(d). I have found no case, in this circuit or elsewhere, finding authorization under § 1119 to rule on [27]initial registerability where that determination was so legally and factually disconnected from the accompanying dispute involving the registered mark.

Accordingly, I conclude that this court is without statutory authority to determine the ultimate registerability of the parties' "St. Louis Rams" marks or direct the PTO's disposition of the pending trademark applications. Notwithstanding this conclusion, legal determinations will be reached in this action through claims properly before the court that will affect the registerability of the competing federal applications, specifically a resolution of the parties' competing priority claims to the "St. Louis Rams" mark. Legal priority in this mark is the controlling issue in plaintiffs claims for declaratory judgments that it did not infringe defendants' federal and state trademark rights and that defendants infringed plaintiffs Wisconsin registration and legal priority provides the core of defendants' counterclaim seeking cancellation of plaintiffs Wisconsin registration. However, jurisdiction to determine the controlling issue of priority is not tantamount to jurisdiction to order the PTO to grant or deny pending trademark applications. The PTO must reach its own registerability decision, albeit consistent with this court's ruling on the underlying disputes.

Because this court lacks authority over the registerability issues, the following claims and counterclaims will be dismissed for lack of statutory authority to grant the requested relief plaintiffs request for declaratory judgment that its federal trademark applications are "superior in both time and right" to those of defendant; plaintiffs request for injunctive [28]relief ordering the PTO to reject defendants' applications; and defendants' requests for injunctive relief ordering the PTO to sustain defendants' objections to plaintiffs March 10, 1995 applications and refuse registration to plaintiffs four remaining applications for the mark "St. Louis Rams."

Additionally, plaintiff has requested a declaratory judgment that defendants committed fraud on the PTO by falsifying the first-use date and specimen in Application No. 74/666,08 1. -Without identifying a statutory basis for this claim, plaintiff asserts it as an additional grounds for ordering dismissal of defendants' application. Because the allegedly fraudulent applications are pending with the PTO, plaintiffs claim must be dismissed as an impermissible attempt to obtain federal court intervention in a registration proceeding. See Metric, 185 F.2d at 717. Additionally, plaintiffs claim is premature under 15 U.S.C. § 1120, which authorizes federal suits for monetary damages against parties who have "procure[d] registration in the Patent and Trademark Office" through fraudulent means. The Court of Appeals for the Seventh Circuit has held that claims under § 1120 are not viable until the PTO has actually registered the challenged mark. See Country Mutual Ins. Co. v. American Farm Bureau Federation,

876 F.2d 599, 601 (7th Cir. 1989) (recognizing legislative policy of requiring parties to litigate disputes over application in PTO before coming to federal courts). Plaintiffs claim for declaratory relief regarding defendants' alleged fraud on the PTO will be dismissed as unripe.

[29] B. Rights in the "St. Louis Rams" Mark

As mentioned above, the parties' core dispute over their competing rights in the mark "St. Louis Rams" controls several of the remaining claims. Plaintiffs claim for infringement of its Wisconsin registration is brought (presumably) under Wis. Star. § 132.033, which authorizes suit by any owner of a state registered mark against a party using a "counterfeit mark" identical or substantially identical to the mark registered. In defense to an action under § 132.033, defendant may show that it "acquired the right under common law or federal law to manufacture, use, display or sell an identical mark" before plaintiffs Wisconsin registration issued. Wis. Stat. § 132.033(5)(f). Similarly, defendants' counterclaim to cancel plaintiffs Wisconsin registration is governed by Wis. Star. § 132.01(7)(a), which requires the secretary of state to cancel such registration if this court finds that plaintiff does riot have "the right to exclusive use" of the registered "St. Louis Rams" mark. Therefore, defendants will prevail on both of these claims if they had acquired protectible trademark rights in the "St. Louis Rams" mark before the date of plaintiffs Wisconsin registration. As for plaintiffs declaratory claim of non-infringement, which is discussed in more detail later, the outcome

turns heavily on the parties' competing rights in the mark.

It is well-established that a party may acquire a protectible right in a trademark only through use of that mark in connection with its product or products. See United Drug Co. [30]v. Theodore Rectanus Co., 248 U.S. 90, 97 (1918); Zazu Designs v. L'Oreal, S.A., 979 F.2d 499, 503 (7th Cir. 1992); see also McCarthy at § 16:1 ("ownership of trademark or trade dress rights in the United States is obtained by actual use of a symbol to identify the goods or *services of* one seller and distinguish them from those offered by others"). Trademark rights cannot exist in the abstract, but only in connection with an existing commercial *enterprise and* only to the extent that the mark connects producer and product. See United Drug, 248 U.S. at 97; Bud v. Perosa, S.R.L., 139 F.3d 98, 103 (2d Cir. 1998); see also Illinois High School Association v. GTE Vantage Inc., 99 F.3d 244, 246 (7th Cir. 1996) (holding that trademark is nothing more than designation of source and "dies when it ceases to designate"), cert. denied 117 S. Ct. 1083 (1997); McCarthy at § 16:1 (a valid trademark must identify one source and distinguish it from another).

As between competing claimants to a trademark, the party who first appropriates the mark through use acquires superior rights. See United Drug, 248 U.S. at 100; Zazu Designs, 979 F.2d at 503 ("one must win the race to the marketplace to establish the exclusive right to the mark"); McCarthy at § 16:4 ("for inherently distinctive marks, ownership is governed by priority of use"). As the Supreme Court explained, this is because

once the public comes to identify the mark with a particular product and producer, use of the mark on the product of a second party will confuse consumers as to that products origin. United Drug, 248 U.S. at 100. In this respect, priority of trademark rights is quite different from that in copyrights [31]and patents: priority in a trademark is not acquired through discovery or invention of the mark without actual use. See United Drug, 248 U.S. at 97 ("the right to a particular mark grows out of its use, not its mere adoption"); McCarthy at § 16:11 ("Trademark priority is not automatically granted to the person who was first to conceive of the idea of using a given symbol as a mark").

Thus to demonstrate ownership in a protectible trademark, a party must show both 1) that its use-of the mark predated that of others asserting competing rights in the mark and 2) that the mark has been used effectively to designate the party as the source of its product. Some courts have held that the degree of "use" necessary to make each of these showings differs, allowing parties to demonstrate priority through minimal preliminary use of a mark as long as later, more substantial use gives the mark the ability to designate to consumers the product's source. See McCarthy at § 16:6 (citing cases in which priority established through bona fide test marketing, promotional gifts and experimental sales in small volume). However, in Zazu Designs, 979 F.2d at 502-04, the Court of Appeals for the Seventh Circuit rejected this approach. The court of appeals found that the plaintiffs preliminary sales of shampoo and conditioner under the "Zazu" mark, including a few local over-the-counter transactions, and two small

interstate shipments to acquaintances, failed to establish priority over defendant, who subsequently applied for federal registration of the mark and began national sales of its own "Zazu" hair care products. Id. The court reached this conclusion [32]because the plaintiffs preliminary sales did not "link the Zazu mark with [the plaintiffs] product in the minds of consumers [or] put other producers on notice." Id. at 503. In so concluding, the court effectively held that trademark priority does not go to the first party to make use of the mark at all, but the first party for whom the mark serves as a designation of source.

I note that under the Lanham Act, a party may register a mark through 15 U.S.C. § 1051 and thereby acquire trademark rights before it has engaged in use sufficient to give rise to common law rights. See Zazu Designs, 979 F.2d at 503. Moreover, the act provides that federal registration of a mark confers upon the owner a right of priority dating back to the filing of the application. 15 U.S.C. § 1057(c). However, to obtain registration, an applicant still must demonstrate that it has engaged in a "bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark." 15 U.S.C. § 1127 (defining "use in commerce" required for registration under § 1051(a)(1) and (d)(I)). Because no party has obtained a federal registration in the "St. Louis Rams" mark, these standards do not apply. Plaintiffs effort to assert inchoate trademark rights though its pending intent-to-use applications will be addressed below.

1. Defendants' rights prior to plaintiff's Wisconsin registration

As in many trademark disputes, the trick here is to determine whether and at what [33]time each party's use was sufficient to give rise to protectible trademark rights. Courts have held that this determination is to be made on a case-by-case basis, considering the totality of the circumstances. See New West Corp. v. NYM Co. of California, 595 F.2d 1194, 1200 (9th Cir. 1979). The prevailing test is whether the use is "sufficiently public to identify or distinguish the marked goods in an appropriate segment of the public mind as those of the adopter of the mark. " New England Duplicating Co. Inc. v. Mende, 190 F.2d 415, 418 (1st Cir. 195 1), quoted in New West, 5 95 F.2 d at 12 00, and Marvel Comics Ltd. v. Defiant, 83 7 I. Supp. 546, 548-49 (S.D.N.Y. 1993). In Zazu Designs, 979 F.2d at 503, the court followed this approach, finding that a handful of public sales and sales to friends was insufficient use to establish trademark rights because the sales neither linked the asserted mark with the product in the minds of consumers nor put other producers on notice.

The undisputed facts show that, by the time plaintiff filed its Wisconsin registration in February 1995, a substantial portion of the public associated the mark "St. Louis Rams" with defendants' football club. The club's anticipated move to St. Louis was nationally publicized and received extensive coverage. The St. Louis Post-Dispatch printed a pull-out section entitled "St. Louis Rams," which described the history and players of

defendants' Rams football club. Vendors were selling unlicenced apparel bearing the "St. Louis Rams" mark to football fans excited about the announced relocation, Even before the January 1995 move announcement, a "St. Louis Rams" fan club had been formed that followed the play [34]of defendants' team. The fact that "Los Angeles Rams" remained the official name of the club until at least April 1995 is irrelevant. A product or organization may be designated by more than one trademark. See Old Dutch Foods, Inc. v. Dan Dee Pretzel & Potato Chip Co., 477 F.2d 150, 154 (6th Cir. 1973). Also, the uncertainty of the move in February and the fact that the club had not yet expressed its intention publicly to take on the name "St. Louis Rams" (rather than "Missouri Rams" or "St. Louis Stallions" two possibilities suggested by plaintiff) have no significance, as the facts show that the public and all relevant commentators associated the mark "St. Louis Rams" with defendants' football club despite this uncertainty,

Plaintiff argues that public association is not enough because defendants themselves never "used" the mark "St. Louis Rams" before April 12, 1995. Consistently, courts considering sufficient "use" in trademark cases speak in terms of the asserted trademark holder's use of its mark and define "use" to mean the public sale of a product to which the mark is affixed. See Zazu Designs, 979 F.2d at 503. It is undisputed that defendants did not sell or even market any product under the "St. Louis Rams" mark before plaintiff obtained its Wisconsin registration. However, in rare circumstances, parties have been found to possess rights in a nickname or abbreviation of an existing mark that was used solely by

others to designate its product. See Coca-Cola Co. v. Busch, 44 F. Supp. 405, 4 10 (D. Pa. 1942) ("Coke" protectible nickname for "Coca-Cola"); Big Blue Products, Inc. v. [35]International Business Machines Corp., 19 U.S.P.Q.2d 1072 (T.T.A.B. 199 1) ("Big Blue" could be protectible nickname for I.B.M.); Volkswagen A.G. v. Thermo-Chem Corp., 185 U.S.P.Q. 561 (T.T.A.B. 1975) ("Bug" protectible nickname for Volkswagen autos); Peiper v. Playboy Enterprises, Inc., 179 U.S.P.Q. 318 (T.T.A.B. 1973) ("Bunny Club" protectible nickname for Playboys clubs); American Stock Exchange, Inc. v. American Express Co., 207 U.S.P.Q. 356 (T.T.A.B. 1970) ("AM EX CO" protectible abbreviation for American Express Company), The Federal Circuit has observed that "the courts and the [Trademark Trial and Appeal] Board generally have recognized that abbreviations and nicknames ... used only by the public give rise to protectible rights in the owners of the trade name or mark which the public modified." National Cable Television Ass., Inc. v. American Cinema Editors, Inc., 937 F.2d 1572, 1577-78 (Fed. Cir. 1991) (emphasis in original). Professor McCarthy approves of these cases and their emphasis on public use of the mark: "Jilt is public use that will set the stage for confusion, which is the evil to be remedied in trademark cases." McCarthy at § 7: 1 S.

The public use of the mark "St. Louis Rams" to designate defendants' football club is similar to the public abbreviations and nicknames found protectible in the cases cited above. Although "St. Louis Rams" is not really an abbreviation of or nickname for defendants' "Los Angeles Rams" mark, it was a clear and obvious

adaptation of the mark inspired and to some extent encouraged by defendants' relocation announcement in January [36]1995. See Indianapolis Colts, Inc. v. Metropolitan Baltimore Football Club Ltd., 34 F.3d 410, 413 (7th Cir. 1994) (recognizing that the plaintiffs old "Baltimore Colts" and new "Indianapolis Colts" marks designate the "same team, merely having a different home base and therefore a different geographical component in its name"). I am persuaded by the cases holding that a party can acquire trademark rights in a modified version of its existing mark that has been adopted and used solely by the public. Failing to extend rights to such a mark in this case would allow plaintiff to adopt the modified mark after the public has come to associate it with defendants, therefore failing to serve the trademark law's core goal of preventing public confusion about the source of a product. See United Drug, 248 U.S. at 100. The fact that such an approach emphasizes the actions and perceptions of the media and consumer rather than the conduct of the asserted trademark holder is consistent with the approach toward trademark rights taken by the Seventh Circuit. See Illinois High School Ass'n, 99 F.3d at 247 (recognizing that trademark rights subject to media and public use in that marks may lose protection when public use makes them generic, such as "aspirin" or "thermos," and that when public comes to associate different product with mark, first user cannot withdraw that mark from the public domain).

By February 1995, the media use and public association of the "St. Louis Rams" mark with defendants was sufficient to allow the mark to designate defendants as the source of its products. Because the undisputed facts

show that this "use" predated any equivalent use by [37]plaintiff, defendants have established priority and a protectible interest in the mark that predated plaintiffs Wisconsin registration. Plaintiffs only asserted "use" of the "St. Louis Rams" prior to defendants' relocation announcement was its invention, some internal developments of accompanying designs, and a telephone call to a clothing retailer in which sales of "St. Louis Rams" apparel were discussed. These actions are even less substantial than the over-the-counter shampoo sales found insufficient to establish priority by the court of appeals in Zazu Designs, 979 F.2d at 503, and certainly did not create a link between the "St. Louis Rams" mark and plaintiffs products in the minds of consumers or put other producers on notice of plaintiffs adoption of the mark.

Accordingly, plaintiffs claim for infringement of its Wisconsin registration under Wis. Star. § 132.033 fails because the undisputed facts show that defendants had "acquired the right under common law. . . to manufacture, use, display or sell an identical mark" before plaintiff obtained its registration. Wis. Star. § 132.033(5)(f). Defendants' counterclaim to cancel plaintiffs Wisconsin registration under Wis. Star. § 132.01(7)(a) prevails because plaintiff does not have "the right to exclusive use" of the registered "St. Louis Rams" mark.

2. Plaintiffs claim for declaration of non-infringement

Plaintiff seeks a declaratory judgment that it has not infringed "any of defendants' federally registered, state

registered or unregistered trademarks." To initiate a declaratory [38]action for non-infringement of a trademark, plaintiff must demonstrate that an actual controversy exists by showing actions by defendants that create a "reasonable apprehension

that . . . plaintiff will face an infringement suit or the threat of one if it commences or continues its questionable activity." G. Heileman Brewing Co. v. Anheuser-Busch, Inc., 873 F.2d 985, 990 (7th Cir. 1989). Plaintiff can meet this burden by showing that defendant has asserted its exclusive rights to the "St. Louis Rams" mark against plaintiff. See id. ("A reasonable apprehension of an infringement suit may be based upon the defendants assertion of exclusive rights against another party."). Defendants made a sufficient assertion of exclusive rights both through their August 16, 1995 cease and desist letter to plaintiff and by instituting the opposition proceedings in the PTO.

Although defendants have not asserted an infringement counterclaim in this action, in support of their motion for summary judgment over plaintiffs non-infringement claim, they contend that plaintiffs past limited use of the "St. Louis Rams" mark and proposed future use infringes defendants' common law rights in the mark. Infringement of unregistered marks is actionable under 15 U.S.C. § 1125(a). See Zazu Designs, 979 F.2d at 502. Such a claim requires a showing that 1) defendants have a protectible trademark and 2) a "likelihood of confusion" will exist as to the origin of plaintiffs products. See International Kennel Club of Chicago, Inc. v. Mighty Star, Inc., 846 F.2d 1079, 1084 (7th Cir.

1988). As established above, defendants posses protectible rights in the mark "St. Louis [39]Rams" that predate any interest plaintiff may have in the mark. Additionally, plaintiff does not contest that a likelihood of confusion exists between the parties' "St. Louis Rams" marks. In fact, plaintiff itself asserts that the public assumes plaintiffs apparel is associated with defendants' football team. Plaintiff argues that this constitutes "reverse confusion," which occurs when a larger junior user saturates a market with products bearing the trademark of a smaller, senior user. See Sands, Taylor & Wood Co. v. Quaker Oats CO., 978 F.2d 947, 957 (7th Cir. 1992). Plaintiffs "reverse confusion" argument fails because plaintiff is not a senior user of the "St. Louis Rams" mark; the public "use" of the mark directly following defendants' January 1995 relocation announcement gave defendants priority rights in the mark over plaintiffs subsequent state registration, federal applications and minimal sales and marketing. Because the two-prong test for infringement is met under the undisputed facts, defendants are entitled to summary judgment on plaintiffs claim of non-infringement.

C. Unfair Competition

Defendants have undertaken several efforts to protect their trademark rights in their unregistered "St. Louis Rams" and registered "Rams" marks, including cease and desist letters sent to plaintiff and notifications on the packaging of "St. Louis Rams" products stating that "[t]he names, symbols, emblems, designs, logos, and other indicia of the NFL and its member clubs are

registered in the United States patent and Trademark Office [40]("PTO") and are protectible against unauthorized use." Plaintiff contends that these actions constituted unfair competition and deceptive advertising under federal, Wisconsin and Missouri laws. Plaintiff provides no further guidance as to the statutory or common law basis for these claims and no explanation why this federal court should hear identical claims under both Wisconsin and Missouri law. In any event, defendants counter this claim as if it were brought under the Lanham Act, 15 U.S.C. § 1125(a) and cite cases holding that the standards for unfair competition and false advertising claims in Missouri and Wisconsin minor federal law. Plaintiff does not contest this characterization of its claim or advance any more favorable grounds for unfair competition recovery; this court is under no obligation to undertake that task on plaintiffs behalf. See Little, 71 F.3d at 641; United States v. Giovannetti, 919 F.2d 1223, 1230 (7th Cir. 1990) ("A litigant who fails to press a point by supporting it with pertinent authority, or by showing why it is a good point despite a lack of supporting authority or in the face of contrary authority, forfeits the point.") (emphasis in original).

To advance a claim for unfair competition under the Lanham Act, a party must demonstrate that it has been or is likely to be damaged by the allegedly deceptive statements. § 1125(a)(1). See also L.S. Heath &--Son, Inc. v. AT & T Information Systems. Inc., 9 F.3d 561, 575 (7th Cir. 1993) (holding that standing to allege false advertising claim under 1125(a) requires "discernible competitive injury" and recovery under act requires

showing [41]of damage from "actual consumer reliance on the misleading statements"); Dovenmuehle v. Gilldorn Mortgage Midwest Corp., 871 F.2d 697, 700 (7th Cir. 1989) (standing under 1125(a) requires existence of "reasonable interest to be protected" from prohibited conduct). Accord Tim Tones Enterprises v. Linscott, 142 Wis. 2d 56, 70, 416 N.W.2d 670 (Ct. App. 1987) (requiring plaintiff bringing claim under Wisconsin unfair trade practices statute, Wis. Star. § 100,18, to demonstrate causal connection between alleged illegal practices and pecuniary losses). From its complaint and proposed conclusions of law, I understand plaintiffs position to be that defendants' efforts to protect the "St. Louis Rams" mark harmed plaintiff by dissuading potential consumers and companies from purchasing or licensing plaintiffs "St. Louis Rams" merchandise and mark.

As for defendants' cease and desist letters, such communications are not actionable under § I 125(a) unless they contain false statements or are sent in bad faith. See Heinz v. Frank Lloyd Wright Foundation, 762 F. Supp. 804, 807-08 (N.D. Ill. 1991). Plaintiff does not argue that defendants' letters met either of these qualifications and cannot do so given the fact that defendants possessed a protectible interest in the "St. Louis Rams" mark at the time the letters were sent. Additionally, plaintiff has not shown any consumer reliance on the allegedly misleading statements regarding defendants' federal registrations. See Celotex Corp. v. Catrett, 477 U.S. 317, 322 (1986) (summary judgment appropriate when party "fails to make a showing sufficient to establish the existence of an

element essential to that [42]party's case, and on which that party will bear the burden of proof at trial"). Even if consumers were misled into believing that defendants had a federal registration in the "St. Louis Rams" mark, such confusion would not have injured plaintiff-, at all relevant times defendants held a protectible trademark interest in the mark under common law that prevented plaintiff from making the sales or entering into the licensing agreements that plaintiff claims to have lost. Because plaintiff was not injured by defendants' statements regarding trademark registration, it is unnecessary to consider whether those statements were false or misleading in any way. Defendants will be granted summary judgment on this claim.

D. Wis. Star. § 100.20(5)

Plaintiffs sole request for money damages is made under Wis. Stat. § 100.20(5) As defendants point out in the brief in support of their motion for summary judgment, this statutory provision authorizes suit to recover double damages for financial loss resulting from violations of orders issued under § 100.20 by the Wisconsin Department of Agriculture, Trade and Consumer Protection. No such order is present here and plaintiff has provided no explanation why a claim for damages under this statute was included in the complaint. Defendants are entitled to summary judgment as to this claim.

[43]E. Defendants' "Rams" Registration

Under 15 U.S.C. § 1064, a federal trademark registration that has been on the registry for more than five years can be canceled for a limited number of reasons, one of which is that the mark has become "the generic name for the goods or services, or a portion thereof, for which it is registered, § 1064(3). *See* also Shakespeare Co. v. Silverstar Corp. of America, 9 F.3d 1091, 1092 (4th Cir. 1993) (holding that registration cancellation under § 1064 limited to statutorily enumerated grounds). Plaintiff contends that defendants' registration No. 971,048 in the mark "Rams," which has been on the registry for over 20 years, is generic and should be canceled.

"A generic term is one that is commonly used to name or designate a kind of goods. Mil-Mar Shoe Co. v. Shonac Corp., 75 F.3d 1153, 1157 (7th Cir. 1996) (citing Liquid Controls Corp. v. Liquid Control Corp., 802 F.2d 934, 936 (7th Cir. 1986)). A generic term cannot become a trademark, which designates the source of a product, because it "merely specifies the type, or genus, of thing into which common linguistic usage consigns that product." Bimix, Inc. v. JS &A Group, Inc., 699 F.2d 901, 905 (7th Cir. 1983). Applying this definition, the Court of Appeals for the Seventh Circuit has found that the term "Warehouse Shoes" is a generic designation for a chain of shoe stores, Mil-Mar Shoe, 75 F.3d at 1157-61, and "Liquid Controls" is a generic designation for devices that dispense and mix liquids, Liquid Controls, 802 F.2d at 938. See also Illinois High School Ass'n, 99 F.3d [44]at 247 (recognizing that terms "aspirin" and "thermos" became generic and lost trademark protection).

Plaintiff contends that the mark "Rams" has become generic because the name is shared by several college athletic teams and some unrelated consumer products specifically a work glove and a pick-up truck. Plaintiffs argument is laughably deficient. Defendant's registration No. 971,048 specifies that it is for "entertainment services--namely, professional football exhibitions." Therefore, the product denoted by the "Rams" registration is a professional football team. Plaintiff can make no argument that the term "Rams" is used to denote specifically professional football teams in general. Plaintiff has shown no evidence that any other professional football team is known as the "Rams," let alone that the term is used to refer to all such teams. At best, plaintiffs evidence shows that defendants have allowed other parties to utilize its "Rams" mark. This is not grounds for registration cancellation under § 1064, particularly when none of those other parties produce the same product. Because plaintiff has failed to produce any facts supporting its challenge to registration No. 971,048, defendants are entitled to summary judgment on plaintiffs claims for declaratory and injunctive relief seeking cancellation of defendants' registration.

F. Attorney Fees

In federal courts, the general rule is that parties will pay their own attorney fees. See [45]Chambers v. Nasco, Inc., 501 U.S. 32, 45 (1991) (recognizing that "American Rule" prohibits fee shifting in most cases). Over time, Congress and the courts have carved out exceptions to this rule. Citing two of these exceptions, defendants seek

to recover their attorney fees from plaintiff. First, defendants seek an award under the "inherent powers" of this court to sanction bad faith litigation. As described by the Supreme Court in Chambers, 501 U.S. at 45-46, such awards are available against a party that has litigated in bad faith, vexatiously or for oppressive reasons. However, such fees awards are not commonplace, see United States v. Fidelity and Deposit Co. of Maryland, 986 F.2d I 110, 1120 (7th Cir. 1993), but are limited to instances in which a party has practiced fraud upon the court, delayed or disrupted the litigation, hampered enforcement of a court order or defiled the "very temple of justice." Chambers, 501 U.S. at 46. Although plaintiffs conduct in this litigation is questionable as to certain claims, it does not satisfy this standard. Defendants' request for an award of attorney fees under the inherent powers of this court will be denied.

The Lanham Act, at 15 U.S.C. § 11 17(a), provides that "in exceptional cases" a court may award attorney *fees to* a prevailing party. The Court of Appeals for the Seventh Circuit has held that fees are available to a Lanham Act defendant when the suit brought by the plaintiff is "oppressive." Door Systems, Inc. v. Pro-Line Door Systems, Inc., 126 F.3d 1028, 1032 (7th Cir. 1997). A suit is determined oppressive on the basis of its merit, or lack [46]thereof, and the cost of defending. See id. Again, I do not find plaintiffs complaint sufficiently devoid of merit and excessively burdensome to defend against to justify an award of attorney fees under § 1117(a). Defendants' request for fees will be denied.

ORDER

IT IS ORDERED that defendants' motion for summary judgment is GRANTED as to the following claims:

1) plaintiffs claims

a) for declaratory relief holding that defendants infringed plaintiffs "St. Louis Rams" trademark under Wisconsin law;

b) for declaratory relief holding that plaintiff did not infringe any of federal or state trademark rights;

c) for declaratory relief holding that defendants engaged in unfair competition and deceptive advertising under federal and state law in connection with statements concerning the registration status of the "St. Louis Rams" mark;

d) for declaratory relief holding that defendants' federal trademark registration No. 971,048 for the mark "Rams" is subject to cancellation;

e) for injunctive relief ordering the Patent and Trademark Office to cancel defendants' federal registration No. 971,048; [47]
f) for monetary relief under Wis. Stat. §100.20(5); and

2) defendants' counterclaim for injunctive relief

ordering the Wisconsin Secretary of State to cancel plaintiffs Wisconsin registration of the "St. Louis Rams" mark.

Further, IT IS ORDERED that the following claims and counterclaims are DISMISSED as premature because this court does not have the authority to issue the relief requested:

1) plaintiffs claims

   a) for declaratory relief holding that plaintiffs federal trademark applications in the "St. Louis Rams" mark are "superior in both time and right" to defendants' federal applications for the same mark;

   b) for declaratory relief holding that defendants committed fraud on the United States Patent and Trademark Office in their April 26, 1995 trademark applications for the mark "St. Louis Rams"-,

   c) for injunctive relief ordering the Patent and Trademark Office to reject defendants' trademark applications; and

2) defendants' counterclaims for injunctive relief

   a) ordering the PTO to sustain defendants' opposition to plaintiffs March 10, 1995 federal trademark applications for the mark "St. Louis Rams;" and

b) ordering the PTO to refuse registration for plaintiffs remaining four federal [48]trademark applications for the same mark.

Finally, IT IS ORDERED that defendants' request for attorney fees and plaintiffs request for leave to file a supplemental affidavit are DENIED.

Entered this 24th day of June, 1998.

BY THE COURT:

BARBARA B. CRABB
District Judge

In the
United States Court of Appeals
for the Seventh Circuit
August 31, 1999

Before

Hon. John L. Coffey, Circuit Judge
Hon. Ilana Diamond Rovner, Circuit Judge
Hon. Diane P. Wood, Circuit Judge

JOHNNY BLASTOFF, INC., *Plaintiff-Appellant,*	)	Appeal from the United States District Court for the Western District of Wisconsin.
No. 98-2908 v.	)	
LOS ANGELES RAMS FOOTBALL COMPANY, ST. LOUIS RAMS PARTNERSHIP, NATIONAL FOOTBALL LEAGUE PROPERTIES, INCORPORATED, et al., *Defendants-Appellees*	)	*No. 97 C 0155-Barbara B. Crabb, Judge*

ORDER

On consideration of the petition for rehearing with suggestion for rehearing en banc filed in the above-entitled case on August 18, 1999, by the Plaintiff-appellant, no judge in the active service has requested a vote thereon, and all the judges on the original panel have voted to deny a rehearing. Accordingly,

IT IS ORDERED that the aforesaid petition for rehearing be, and the same is hereby DENIED.

U.S. Constitution - Article I

Article I.

Section 1. All legislative powers herein granted shall be vested in a Congress of the United States, which shall consist of a Senate and House of Representatives.

U.S. Constitution - Article III

Article III.

Section 1. The judicial power of the United States, shall be vested in one Supreme Court, and such inferior courts as the Congress may from time to time ordain and establish. The judges, both of the supreme and inferior courts, shall hold their offices during good behavior, and shall, at stated times receive for their services, a compensation, which shall not be diminished during their continuance in office.

Section 2. The judicial power shall extend to all cases, in law and in equity, arising under this Constitution, the laws of the United States, and treaties made, or which shall be made, under their authority; - to all cases affecting ambassadors, other public ministers and consuls; - to all cases of admiralty and maritime jurisdiction; - to controversies to which the United States shall be a party; - and maritime Jurisdiction; to Controversies to which the United States shall be a

Party;--to Controversies between two or more States; between a State and Citizens of another State; between Citizens of different States,--between Citizens of the same State claiming Land under Grants of different States, and between a State, or the Citizens thereof, and foreign States, Citizens or Subjects.

U.S. Constitution - Amendment I

Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the government for a redress of grievances.

U.S. Constitution - Amendment VII

In suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved, and no fact tried by a jury, shall be otherwise reexamined in any court of the United States, than according to the rules of the common law.

TITLE 15 - COMMERCE AND TRADE

CHAPTER 22 - TRADEMARKS

SUBCHAPTER I - THE PRINCIPAL REGISTER

Sec. 1051. Application for registration; verification

-STATUTE-

(a) Application for use of trademark

(1) The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Commissioner, and such number of specimens or facsimiles of the mark as used as may be required by the Commissioner.

(2) The application shall include specification of the applicant's domicile and citizenship, the date of the applicant's first use of the mark, the date of the applicant's first use of the mark in commerce, the goods in connection with which the mark is used, and a drawing of the mark.

(3) The statement shall be verified by the applicant and specify that -

(A) the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be the owner of the mark sought to be registered;

(B) to the best of the verifier's knowledge and belief, the facts recited in the application are accurate;

(C) the mark is in use in commerce; and

(D) to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive, except that, in the case of every application claiming concurrent use, the applicant shall -

(i) state exceptions to the claim of exclusive use; and

(ii) shall specify, to the extent of the verifier's knowledge -

(I) any concurrent use by others;

(II) the goods on or in connection with which and the areas in which each concurrent use exists;

(III) the periods of each use; and

(IV) the goods and area for which the applicant desires registration.

(4) The applicant shall comply with such rules or regulations as may be prescribed by the Commissioner. The Commissioner shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

(b) Application for bona fide intention to use trademark

(1) A person who has a bona fide intention, under circumstances showing the good faith of such person, to use a trademark in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement, in such form as may be prescribed by the Commissioner.

(2) The application shall include specification of the applicant's domicile and citizenship, the goods in connection with which the applicant has a bona fide intention to use the mark, and a drawing of the mark.

(3) The statement shall be verified by the applicant and specify -

(A) that the person making the verification believes that he or she, or the juristic person in whose behalf he or she makes the verification, to be entitled to use the mark in commerce;

(B) the applicant's bona fide intention to use the mark in commerce;

(C) that, to the best of the verifier's knowledge and belief, the facts recited in the application are accurate; and

(D) that, to the best of the verifier's knowledge and belief, no other person has the right to use such mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on

or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive.

Except for applications filed pursuant to section 1126 of this title, no mark shall be registered until the applicant has met the requirements of subsections (c) and (d) of this section.

(4) The applicant shall comply with such rules or regulations as may be prescribed by the Commissioner. The Commissioner shall promulgate rules prescribing the requirements for the application and for obtaining a filing date herein.

(c) Amendment of application under subsection (b) to conform to requirements of subsection (a)

At any time during examination of an application filed under subsection (b) of this section, an applicant who has made use of the mark in commerce may claim the benefits of such use for purposes of this chapter, by amending his or her application to bring it into conformity with the requirements of subsection (a) of this section.

(d) Verified statement that trademark is used in commerce

(1) Within six months after the date on which the notice of allowance with respect to a mark is issued under section 1063(b)(2) of this title to an applicant under subsection (b) of this section, the applicant shall file in the Patent and Trademark Office, together with such number of specimens or facsimiles of the mark as

used in commerce as may be required by the Commissioner and payment of the prescribed fee, a verified statement that the mark is in use in commerce and specifying the date of the applicant's first use of the mark in commerce and,, (FOOTNOTE 1) those goods or services specified in the notice of allowance on or in connection with which the mark is used in commerce. Subject to examination and acceptance of the statement of use, the mark shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued for those goods or services recited in the statement of use for which the mark is entitled to registration, and notice of registration shall be published in the Official Gazette of the Patent and Trademark Office. Such examination may include an examination of the factors set forth in subsections (a) through (e) of section 1052 of this title. The notice of registration shall specify the goods or services for which the mark is registered. (FOOTNOTE 1) So in original.

(2) The Commissioner shall extend, for one additional 6-month period, the time for filing the statement of use under paragraph (1), upon written request of the applicant before the expiration of the 6-month period provided in paragraph (1). In addition to an extension under the preceding sentence, the Commissioner may, upon a showing of good cause by the applicant, further extend the time for filing the statement of use under paragraph (1) for periods aggregating not more than 24 months, pursuant to written request of the applicant made before the expiration of the last extension granted under this paragraph. Any request for an extension under this

paragraph shall be accompanied by a verified statement that the applicant has a continued bona fide intention to use the mark in commerce and specifying those goods or services identified in the notice of allowance on or in connection with which the applicant has a continued bona fide intention to use the mark in commerce. Any request for an extension under this paragraph shall be accompanied by payment of the prescribed fee. The Commissioner shall issue regulations setting forth guidelines for determining what constitutes good cause for purposes of this paragraph.

(3) The Commissioner shall notify any applicant who files a statement of use of the acceptance or refusal thereof and, if the statement of use is refused, the reasons for the refusal. An applicant may amend the statement of use.

(4) The failure to timely file a verified statement of use under paragraph (1) or an extension request under paragraph (2) shall result in abandonment of the application, unless it can be shown to the satisfaction of the Commissioner that the delay in responding was unintentional, in which case the time for filing may be extended, but for a period not to exceed the period specified in paragraphs (1) and (2) for filing a statement of use.

(e) Designation of resident for service of process and notices If the applicant is not domiciled in the United States he shall designate by a written document filed in the Patent and Trademark Office the name and address of some person resident in the United States on whom

may be served notices or process in proceedings affecting the mark. Such notices or process may be served upon the person so designated by leaving with him or mailing to him a copy thereof at the address specified in the last designation so filed. If the person so designated cannot be found at the address given in the last designation, such notice or process may be served upon the Commissioner.

-SOURCE-

(July 5, 1946, ch. 540, title I, Sec. 1, 60 Stat. 427; Pub. L. 87-772, Sec. 1, Oct. 9, 1962, 76 Stat. 769; Pub. L. 93-596, Sec. 1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 100-667, title I, Sec. 103, Nov. 16, 1988, 102 Stat. 3935; Pub. L. 105-330, title I, Sec. 103, title II, Sec. 201(a), Oct. 30, 1998, 112 Stat. 3064, 3069.)

TITLE 15 - COMMERCE AND TRADE

CHAPTER 22 - TRADEMARKS

SUBCHAPTER I - THE PRINCIPAL REGISTER

Sec. 1057. Certificates of registration

-STATUTE-

(a) Issuance and form

Certificates of registration of marks registered upon the principal register shall be issued in the name of the United States of America, under the seal of the Patent and Trademark Office, and shall be signed by the Commissioner or have his signature placed thereon, and a record thereof shall be kept in the Patent and Trademark Office. The registration shall reproduce the mark, and state that the mark is registered on the principal register under this chapter, the date of the first use of the mark, the date of the first use of the mark in commerce, the particular goods or services for which it is registered, the number and date of the registration, the term thereof, the date on which the application for registration was received in the Patent and Trademark Office, and any conditions and limitations that may be imposed in the registration.

(b) Certificate as prima facie evidence

A certificate of registration of a mark upon the principal register provided by this chapter shall be prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.

(c) Application to register mark considered constructive use

Contingent on the registration of a mark on the principal register provided by this chapter, the filing of the application to register such mark shall constitute constructive use of the mark, conferring a right of priority, nationwide in effect, on or in connection with the goods or services specified in the registration against any other person except for a person whose mark has not been abandoned and who, prior to such filing -

(1) has used the mark;

(2) has filed an application to register the mark which is pending or has resulted in registration of the mark; or

(3) has filed a foreign application to register the mark on the basis of which he or she has acquired a right of priority, and timely files an application under section 1126(d) of this title to register the mark which is pending or has resulted in registration of the mark.

(d) Issuance to assignee A certificate of registration of a mark may be issued to the assignee of the applicant, but the assignment must first be recorded in the Patent

and Trademark Office. In case of change of ownership the Commissioner shall, at the request of the owner and upon a proper showing and the payment of the prescribed fee, issue to such assignee a new certificate of registration of the said mark in the name of such assignee, and for the unexpired part of the original period.

(e) Surrender, cancellation, or amendment by registrant Upon application of the registrant the Commissioner may permit any registration to be surrendered for cancellation, and upon cancellation appropriate entry shall be made in the records of the Patent and Trademark Office. Upon application of the registrant and payment of the prescribed fee, the Commissioner for good cause may permit any registration to be amended or to be disclaimed in part: Provided, That the amendment or disclaimer does not alter materially the character of the mark. Appropriate entry shall be made in the records of the Patent and Trademark Office and upon the certificate of registration or, if said certificate is lost or destroyed, upon a certified copy thereof.

(f) Copies of Patent and Trademark Office records as evidence Copies of any records, books, papers, or drawings belonging to the Patent and Trademark Office relating to marks, and copies of registrations, when authenticated by the seal of the Patent and Trademark Office and certified by the Commissioner, or in his name by an employee of the Office duly designated by the Commissioner, shall be evidence in all cases wherein the originals would be evidence; and any person making application therefor and paying the prescribed fee shall have such copies.

(g) Correction of Patent and Trademark Office mistake Whenever a material mistake in a registration, incurred through the fault of the Patent and Trademark Office, is clearly disclosed by the records of the Office a certificate stating the fact and nature of such mistake, shall be issued without charge and recorded and a printed copy thereof shall be attached to each printed copy of the registration certificate and such corrected registration shall thereafter have the same effect as if the same had been originally issued in such corrected form, or in the discretion of the Commissioner a new certificate of registration may be issued without charge. All certificates of correction heretofore issued in accordance with the rules of the Patent and Trademark Office and the registrations to which they are attached shall have the same force and effect as if such certificates and their issue had been specifically authorized by statute.

(h) Correction of applicant's mistake Whenever a mistake has been made in a registration and a showing has been made that such mistake occurred in good faith through the fault of the applicant, the Commissioner is authorized to issue a certificate of correction or, in his discretion, a new certificate upon the payment of the prescribed fee: Provided, That the correction does not involve such changes in the registration as to require republication of the mark.

-SOURCE-

(July 5, 1946, ch. 540, title I, Sec. 7, 60 Stat. 430; Aug. 17, 1950, ch. 733, 64 Stat. 459; Pub. L. 87-772, Sec. 4, Oct. 9, 1962, 76 Stat. 769; Pub. L. 93-596, Sec.

1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 100-667, title I, Sec. 109, Nov. 16, 1988, 102 Stat. 3938; Pub. L. 105-330, title II, Sec. 201(a)(3), Oct. 30, 1998, 112 Stat. 3070.)

15 USC Sec. 1057 01/05/99

TITLE 15 - COMMERCE AND TRADE

CHAPTER 22 - TRADEMARKS

SUBCHAPTER III - GENERAL PROVISIONS

Sec. 1125. False designations of origin, false descriptions, and dilution forbidden

-STATUTE-

(a) Civil action

(1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which -

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(2) As used in this subsection, the term "any person" includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(b) Importation

Any goods marked or labeled in contravention of the provisions of this section shall not be imported into the United States or admitted to entry at any customhouse of the United States. The owner, importer, or consignee of goods refused entry at any customhouse under this section may have any recourse by protest or appeal that is given under the customs revenue laws or may have the remedy given by this chapter in cases involving goods refused entry or seized.

(c) Remedies for dilution of famous marks

(1) The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection. In determining whether a

mark is distinctive and famous, a court may consider factors such as, but not limited to -

(A) the degree of inherent or acquired distinctiveness of the mark;

(B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;

(C) the duration and extent of advertising and publicity of the mark;

(D) the geographical extent of the trading area in which the mark is used;

(E) the channels of trade for the goods or services with which the mark is used;

(F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought;

(G) the nature and extent of use of the same or similar marks by third parties; and

(H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

(2) In an action brought under this subsection, the owner of the famous mark shall be entitled only to injunctive relief unless the person against whom the injunction is sought willfully intended to trade on the owner's reputation or to cause dilution of the famous mark. If such willful intent is proven, the owner of the famous mark shall also be entitled to the remedies set forth in sections 1117(a) and 1118 of this title, subject to the discretion of the court and the principles of equity.

(3) The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February

20, 1905, or on the principal register shall be a complete bar to an action against that person, with respect to that mark, that is brought by another person under the common law or a statute of a State and that seeks to prevent dilution of the distinctiveness of a mark, label, or form of advertisement.

(4) The following shall not be actionable under this section:

(A) Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark.

(B) Noncommercial use of a mark.

(C) All forms of news reporting and news commentary.

-SOURCE-

(July 5, 1946, ch. 540, title VIII, Sec. 43, 60 Stat. 441; Pub. L. 100-667, title I, Sec. 132, Nov. 16, 1988, 102 Stat. 3946; Pub. L. 102-542, Sec. 3(c), Oct. 27, 1992, 106 Stat. 3568; Pub. L. 104-98, Sec. 3(a), Jan. 16, 1996, 109 Stat. 985.)

TITLE 15 - COMMERCE AND TRADE

CHAPTER 22 - TRADEMARKS

SUBCHAPTER III - GENERAL PROVISIONS

Sec. 1127. Construction and definitions; intent of chapter

-STATUTE-

In the construction of this chapter, unless the contrary is plainly apparent from the context - The United States includes and embraces all territory which is under its jurisdiction and control.

The word "commerce" means all commerce which may lawfully be regulated by Congress.

The term "principal register" refers to the register provided for by sections 1051 to 1072 of this title, and the term "supplemental register" refers to the register provided for by sections 1091 to 1096 of this title.

The term "person" and any other word or term used to designate the applicant or other entitled to a benefit or privilege or rendered liable under the provisions of this chapter includes a juristic person as well as a natural person. The term "juristic person" includes a firm,

corporation, union, association, or other organization capable of suing and being sued in a court of law.

The term "person" also includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

The terms "applicant" and "registrant" embrace the legal representatives, predecessors, successors and assigns of such applicant or registrant.

The term "Commissioner" means the Commissioner of Patents and Trademarks.

The term "related company" means any person whose use of a mark is controlled by the owner of the mark with respect to the nature and quality of the goods or services on or in connection with which the mark is used.

The terms "trade name" and "commercial name" mean any name used by a person to identify his or her business or vocation.

The term "trademark" includes any word, name, symbol, or device, or any combination thereof -

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal

register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.

The term "service mark" means any word, name, symbol, or device, or any combination thereof -

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.

The term "certification mark" means any word, name, symbol, or device, or any combination thereof -

(1) used by a person other than its owner, or

(2) which its owner has a bona fide intention to permit a person other than the owner to use in commerce and files an application to register on the principal register established by this chapter, to certify regional or other origin, material, mode of manufacture, quality, accuracy, or other characteristics of such person's goods or services or that the work or labor on the goods or services was performed by members of a union or other organization.

The term "collective mark" means a trademark or service mark -

(1) used by the members of a cooperative, an association, or other collective group or organization, or

(2) which such cooperative, association, or other collective group or organization has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, and includes marks indicating membership in a union, an association, or other organization.

The term "mark" includes any trademark, service mark, collective mark, or certification mark.

The term "use in commerce" means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce -

(1) on goods when -

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign

country and the person rendering the services is engaged in commerce in connection with the services.

A mark shall be deemed to be "abandoned" if either of the following occurs:

(1) When its use has been discontinued with intent not to resume such use. Intent not to resume may be inferred from circumstances. Nonuse for 3 consecutive years shall be prima facie evidence of abandonment. "Use" of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark.

(2) When any course of conduct of the owner, including acts of omission as well as commission, causes the mark to become the generic name for the goods or services on or in connection with which it is used or otherwise to lose its significance as a mark. Purchaser motivation shall not be a test for determining abandonment under this paragraph.

The term "dilution" means the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of -

(1) competition between the owner of the famous mark and other parties, or

(2) likelihood of confusion, mistake, or deception.

The term "colorable imitation" includes any mark which so resembles a registered mark as to be likely to cause confusion or mistake or to deceive.

The term "registered mark" means a mark registered in the United States Patent and Trademark Office under this chapter or under the Act of March 3, 1881, or the Act of February 20, 1905, or the Act of March 19, 1920. The phrase "marks registered in the Patent and Trademark Office" means registered marks.

The term "Act of March 3, 1881", "Act of February 20, 1905", or "Act of March 19, 1920", means the respective Act as amended.

A "counterfeit" is a spurious mark which is identical with, or substantially indistinguishable from, a registered mark. Words used in the singular include the plural and vice versa.

The intent of this chapter is to regulate commerce within the control of Congress by making actionable the deceptive and misleading use of marks in such commerce; to protect registered marks used in such commerce from interference by State, or territorial legislation; to protect persons engaged in such commerce against unfair competition; to prevent fraud and deception in such commerce by the use of reproductions, copies, counterfeits, or colorable imitations of registered marks; and to provide rights and remedies stipulated by treaties and conventions respecting trade-marks, (FOOTNOTE 1) trade names, and unfair competition entered into between the United States and foreign nations.

(FOOTNOTE 1) So in original. Probably should be "trademarks,".

-SOURCE-

(July 5, 1946, ch. 540, title X, Sec. 45, 60 Stat. 443; Pub. L. 87-772, Sec. 21, Oct. 9, 1962, 76 Stat. 774; Pub. L. 93-596, Sec. 1, Jan. 2, 1975, 88 Stat. 1949; Pub. L. 98-620, title I, Sec. 103, Nov. 8, 1984, 98 Stat. 3335; Pub. L. 100-667, title I, Sec. 134, Nov. 16, 1988, 102 Stat. 3946; Pub. L. 102-542, Sec. 3(d), Oct. 27, 1992, 106 Stat. 3568; Pub. L. 103-465, title V, Sec. 521, Dec. 8, 1994, 108 Stat. 4981; Pub. L. 104-98, Sec. 4, Jan. 16, 1996, 109 Stat. 986.)

TRADEMARK MAILROOM
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US PATENT & TRADEMARK OFFICE

APPLICANT: JOHNNY BLASTOFF, INC.

ADDRESS: 309 Major Way
Sun Prairie, WI 53590

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PRIOR US CL.
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ST. LOUIS RAMS

(Actual size excerpt from R-41, Exh. 40, pg. 9)

No. 99-1066

IN THE

Supreme Court of the United States

JOHNNY BLASTOFF, INC.,

Petitioner,

v.

LOS ANGELES RAMS FOOTBALL COMPANY, ST. LOUIS RAMS PARTNERSHIP, NATIONAL FOOTBALL LEAGUE PROPERTIES, INC. and NATIONAL FOOTBALL LEAGUE,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

RESPONDENTS' BRIEF IN OPPOSITION

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STATEMENT PURSUANT TO RULE 29.6

St. Louis Rams Football Company, Inc., a corporation organized under the laws of the State of Delaware, is the successor in interest to named Respondent Los Angeles Rams Football Company. St. Louis Rams Partnership is a Delaware general partnership, composed of St. Louis Rams Football Company, Inc. National Football League Properties, Inc. is a California corporation owned in equal parts by each of the thirty-two (32) Member Clubs of the National Football League (the "NFL"). The NFL is a New York unincorporated association.

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St. Louis Post-Dispatch, January 18, 1995 Edition	2

STATEMENT OF THE CASE

Respondents, Los Angeles Rams Football Company, St. Louis Rams Partnership (together, the "Rams" or the "Rams Club"), National Football League Properties, Inc. ("NFLP") and National Football League (the "NFL") (collectively, "Respondents"), are the prior users of the trademark ST. LOUIS RAMS. Petitioner Johnny Blastoff, Inc. ("Petitioner") has claimed that its intent-to-use trademark application somehow granted it rights superior to those of Respondents. The District Court for the Western District of Wisconsin correctly applied established precedent to the particular facts of this case and properly dismissed Petitioner's claims and granted Respondents' counterclaims on summary judgment. The Court of Appeals for the Seventh Circuit reviewed the decision below *de novo* and affirmed, in a well-reasoned opinion based upon traditional trademark law principles. Notwithstanding the argumentative, inaccurate and irrelevant "facts" and strained legal theories advanced by Petitioner, as demonstrated in the lower courts' opinions, this is a routine trademark dispute that presents no novel legal issues, and creates no conflict with federal trademark legislation or decisions in other Circuits. Accordingly, this Court should deny the Petition for a writ of certiorari.

An accurate account of the salient facts in this matter, as found by the Court of Appeals and the District Court, is contained in the Appendix to the Petition ("App.") at pages A-3 through A-8 and A-31 through A-43. Briefly stated, beginning at least as early as December 1993 and continuing through 1994, newspaper articles in the St. Louis area reported on the possible relocation of the Los Angeles Rams, a Member Club of the NFL, to St. Louis. App. at A-5, A-34.

By late 1994, a "St. Louis Rams Fan Club" was formed at a St. Louis sports bar. *Id.* On January 17, 1995 Georgia Frontiere, owner of the Los Angeles Rams, held a press conference in St. Louis with Mayor Freeman Bosley at which time the intent to move the Rams to St. Louis was announced. *Id.* at A-5, A-11, A-34. The press conference received significant local and national press coverage, resulting in articles in *USA Today* and the *New York Times*, among others. *Id.* Mayor Bosley was quoted in the *New York Times* as referring to the team as the "St. Louis Rams". *Id.* The January 18, 1995 edition of the *St. Louis Post-Dispatch* included a 16-page pull-out section devoted to the Rams football team, entitled "St. Louis Rams". *Id.* Immediately after the press conference, the Rams club began advertising the sale of "personal seat licenses."[1] By early February 1995, the Rams Club had received more than 72,000 applications for PSLs. *Id.* at A-5-6, A-11-12, A-35-36. Also in January 1995, vendors began selling unauthorized "St. Louis Rams" merchandise and NFLP sent cease and desist letters to these vendors, thereby enforcing the trademark rights of the Rams. *Id.* at A-6, A-12, A-35. Based on these undisputed facts, the Seventh Circuit determined that by February of 1995 a significant portion of the public associated the mark ST. LOUIS RAMS with Respondents. *Id.* at A-12.

Aware of the Rams' announced plan to move to St. Louis, on March 10, 1995 Petitioner filed an intent to use application to register "ST. LOUIS RAMS" in the United States Patent and Trademark office. The Seventh Circuit correctly found that Petitioner's prior activities: (1) development of a "Tower City Rams" design which did not include any reference to the mark St. Louis Rams, and (2) production of a single swatch of material

1. These personal seat licenses ("PSLs") granted holders the right to acquire season tickets for home games of the Rams club in the new domed stadium then under construction in St. Louis.

embroidered with "ST. LOUIS RAMS", were insufficient to establish any public association between the alleged mark and Petitioner or its products. *Id.* at A-12-13.

These undisputed facts compelled the conclusion by both the District Court and the Seventh Circuit that Respondents acquired protectable rights in the mark ST. LOUIS RAMS before Petitioner filed its application for registration or engaged in any commercial use of the designation. The Court of Appeals denied Petitioner's application for rehearing. *Id.* at A-74.

REASONS FOR DENYING THE WRIT

As an initial matter, Petitioner has not complied with the procedural rules of this Court. Furthermore, Petitioner's application for a writ of certiorari should also be denied on substantive grounds. Petitioner asserts various spurious "conflicts" and "clashes" between the Seventh Circuit's decision, and the decisions of other courts and the Lanham Trademark Act (15 U.S.C. § 1051-1127) (as amended in 1989). The Seventh Circuit's decision, however, fits squarely within the principles embodied in the Lanham Act and established trademark law precedent, and presents no important federal question that merits this Court's review.

I. PETITIONER HAS NOT COMPLIED WITH THIS COURT'S RULES GOVERNING PETITIONS FOR CERTIORARI.

The Petition in this matter was first filed with the Court on November 24, 1999, and was rejected by the Court by letter dated November 26, 1999, due to procedural deficiencies. The amended Petition, however, filed with the

Court on December 17 and docketed shortly thereafter, incorporates numerous substantive changes from the first submission. Petitioner has therefore evaded this Court's strict filing deadlines by using an extension of time to correct *procedural* defects to make material, *substantive* changes to its Petition. For example, Petitioner substantially revised and added to the "Questions Presented", the "Statement of the Case" and the "Reasons for Granting the Writ" sections of his Petition. Specifically, Petitioner used the extension of time to revise Questions 4 and 5, to add sub-questions viii through xii to Question 6, to add Questions 7 and 8, to revise the arguments presented in paragraphs numbered H and P, and to add arguments paragraph numbered W, X, Y, Z, AA, and BB to the Petition. Even before reaching the substantive flaws in the Petition as addressed below, the Writ should be denied on this procedural basis alone.

II. THE SEVENTH CIRCUIT'S DECISION CREATES NO CONFLICT AMONG THE CIRCUIT COURTS OF APPEAL.

There is no conflict between the Seventh Circuit's decision in this matter and the Third Circuit's decision in *Lucent Info. Management, Inc. v. Lucent Techs. Inc.*, 186 F.3d 311 (3d Cir. 1999). As recognized by the *Lucent* court, and consistent with at least a century of precedent, exclusive trademark rights are based on priority of use. *Id.* at 315; *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90 (1918); *see* Lanham Act Section 7(c), 15 U.S.C. § 1057(c) ("the filing of [an] application to register [a mark] shall . . . confer[ ] a right of priority, nationwide in effect, . . . against any other person *except for a person . . . who, prior to such filing, has used the mark.*"). Just as the Court did in *Lucent*, the District Court and Seventh Circuit in this case examined

use of the trademark at issue by one party prior to the filing of an intent to use trademark application by another, to determine whether such use was sufficient to establish priority as a matter of law. 186 F.3d at 315. Both the Seventh Circuit in this case, and the Court of Appeals in *Lucent*, applied the standard accepted across the Circuits: priority resides in the party who is first to establish use "in a way sufficiently public to identify or distinguish the marked goods in an appropriate segment of the public mind as those of the adopter of the mark." App. at A-10, quoting *New West Corp. v. NYM Co. of Cal., Inc.*, 595 F.2d 1194, 1200 (9th Cir. 1979); *Lucent*, 186 F.3d at 315, quoting *Blue Bell, Inc. v. Farah Mfg. Co., Inc.*, 508 F.2d 1260, 1266 (5th Cir. 1975).

The Seventh Circuit properly followed the well-accepted principle that "[t]he determination of whether a party has established protectable rights in a trademark is made on a case by case basis, considering the totality of the circumstances." App. at A-10, citing *New West*, 595 F.2d at 1200. In *Lucent*, the Third Circuit determined that the plaintiff, basing its claim of priority on a single sale of a product to an acquaintance of two officers of the company (*see Lucent*, 186 F.3d at 317), failed to establish trademark rights superior to the intent to use applicant. In stark contrast, Respondents in this case amply demonstrated that prior to Petitioner's application for registration, use of the mark ST. LOUIS RAMS was sufficiently widespread and public that a significant portion of the public identified the designation with the Rams Club. *See* App. at A-12.

III. IN REJECTING PETITIONER'S CLAIMS, THE SEVENTH CIRCUIT RELIED ON TRADITIONAL TRADEMARK LAW PRINCIPLES.

A. The Seventh Circuit's Decision Is Consistent With Seventh Circuit Precedent.

No "clash" exists between the Seventh Circuit's decision in this matter and prior Seventh Circuit precedent.[2] The Court here cited and followed its prior holdings in *Zazu Designs v. L'Oreal, S.A.*, 979 F.2d 499 (7th Cir. 1992), and *Indianapolis Colts, Inc. v. Metropolitan Baltimore Football Club Ltd. Partnership*, 34 F.3d 410 (7th Cir. 1994).

Applying the analysis articulated in *Zazu*, the Court of Appeals found that Respondents were the first to appropriate the mark ST. LOUIS RAMS through use which served to establish the mark as a designation of source. *See* App. at A-10, A-12. Similarly, relying on *Indianapolis Colts*, the Panel found "strong support" for the proposition that Respondents had a long established priority in the name "RAMS" for the same professional football team, "regardless of urban affiliation." App. at A-13. Just as the holding in *Indianapolis Colts* does not prevent others from using "Colts" to designate anything besides the Colts professional football team, the *Blastoff* decision does not preclude others from exploiting the word "Rams", unless it is used in a setting that will lead consumers to believe it designates the Rams professional football team. *See Indianapolis Colts*, 34 F.3d

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2. Of course, even if the Seventh Circuit's decision in this case were not fully consistent with its own prior decisions, no conflict warranting review by this Court would exist. *See* Supreme Court R. 10.

at 416. Key to the courts' decisions in this case that Petitioner itself has conceded a likelihood of confusion between the source of its goods and the Rams Club. App. at A-16, A-19.

The holding that "Rams" is not generic for a professional football team is, likewise, fully consistent with the Seventh Circuit's decision in *Illinois High School Ass'n v. GTE Vantage, Inc.*, 99 F.3d 244 (7th Cir. 1996). In *Illinois High School*, the Court did not find the phrase "March Madness" generic, as a result of dual use. Judge Posner simply held that each of the NCAA and Illinois High School had a legitimate right to use the designation in connection with their respective tournaments. *Id.* at 247. In contrast, a finding of genericness requires proof that the mark is a commonly used term to denote a type of goods. *E.g.*, *Mil-Mar Shoe Co. v. Shonac Corp.*, 75 F.3d 1153, 1157 (7th Cir. 1996). Petitioner's claim that "Rams" is generic was correctly dismissed by the Seventh Circuit because Petitioner did not and cannot provide any evidence showing: (i) that "Rams" or "St. Louis Rams" is the common linguistic term for a professional football team; (ii) that the "Rams" or "St. Louis Rams" marks have become a common term for professional football teams generally; or (iii) that any other professional team is known as the Rams (or as the "St. Louis Rams"), except the predecessor Los Angeles Rams. App. at A-20-22.

B. The Trademark Law Revision Act of 1989 Did Not Abolish the Principal That Trademark Rights Spring From Use.

Petitioner's criticism of the Seventh Circuit's reliance on *The Money Store v. Harriscorp Fin., Inc.*, 689 F.2d 666 (7th Cir. 1982), is nonsensical. The Seventh Circuit correctly cited *Money Store* for the unassailable principle that "a trademark application is always subject to previously established common law trademark rights of another party." App. at A-14. Petitioner's suggestion that the Lanham Act amendment permitting applications for trademark registration based on intent to use overruled this principle has no basis in law or fact.

Petitioner asks this Court to rule that the first to file an intent to use application for a federal trademark registration has superior rights as of the filing date of the application, irrespective of prior use by and public association of the mark with another. But the Trademark Law Revision Act, cited repeatedly by Petitioner, did not abolish the use-based foundation of United States trademark law. The intent to use provisions were not designed to encourage or reward a party, like Petitioner, by according prior rights to one who races to file a trademark application after the public has come to associate the mark with another. The rule proposed by Petitioner would create a perverted incentive for trademark squatters. The foundation of United States trademark law is that the exclusive right to a distinctive mark belongs to the party that first uses the mark in commerce to designate the source of its goods or services. The reason that priority of use determines the rights as between conflicting claimants to a mark "is that purchasers have come to understand the mark as indicating the origin of the wares, so that its use by

a second producer amounts to an attempt to sell his as those of his competitor." *United Drug Co.*, 248 U.S. at 100. The Seventh Circuit's decision comports with the letter and spirit of our federal trademark law, and nearly one hundred years of precedent.

Petitioner does not dispute the finding that by February 1995 the public associated the name ST. LOUIS RAMS with Respondents. Rather, Petitioner contends that the public's and the media's widespread adoption and use of ST. LOUIS RAMS — to refer to the Rams organization — was not use *by* Respondents, and therefore should be disregarded. Petitioner argues, without support, that *National Cable Television Ass'n., Inc. v. American Cinema Editors, Inc.*, 937 F.2d 1572, 1577-78 (Fed. Cir. 1991), should be "updated, distinguished or rejected". Petition at 11.

In *National Cable Television*, the Federal Circuit observed that

> even without use directly by the claimant of the rights, the courts and the [Trademark Trial and Appeal] Board generally have recognized that abbreviations and nicknames of trademarks or names used only by the public give rise to protectable rights in the owners of the trade name or mark which the public modified.

937 F.2d at 1577-78 (citations omitted). This principle has wide support because the primary objective of our trademark law is to protect against consumer confusion. *See United Drug Co.*, 248 U.S. at 100; J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 7:18 (3d ed. & Supp. 1999). Once a name or nickname becomes associated

with a particular entity as a result of use by consumers, the trade and the news media, this use inures to the benefit of that entity and use by another is likely to cause confusion.[3]

The Seventh Circuit determined that Respondents have priority in the mark ST. LOUIS RAMS as a result, *inter alia*, of the public's and the media's extensive use of ST. LOUIS RAMS to designate Respondents' professional football team. This holding is consistent with an established line of cases cited with approval by the Federal Circuit in *National Cable*, which was decided after the amendments to the Lanham Act upon which Petitioner relies. *Id.*, 937 F.2d at 1577-78 n.3. The Seventh Circuit's recognition of rights created by public use is also consistent with the post amendment decision in *Maryland Stadium Auth. v. Becker*, 806 F. Supp. 1236 (D. Md. 1992). There, the District Court of Maryland held that promotional events or media coverage may satisfy the requirement of "adoption and use" sufficient to vest trademark rights, and that the public sale of a product is not the only means by which sufficient use may be established. *Id.*, 806 F. Supp. at 1239. Respondents' long established rights in the mark "Rams" for a professional football team and related merchandise, combined with the substantial use of ST. LOUIS RAMS by the public and media to designate the same team, was more than sufficient "use" upon which the District Court and Seventh Circuit determined Respondents' priority.

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3. Petitioner claims that this is a "reverse confusion" case and because it is the "little guy", it is somehow entitled to use the ST. LOUIS RAMS mark . Petition at 21-22. This is not, however, a reverse confusion case because Respondents used the mark ST. LOUIS RAMS prior to any commercial use by Petitioner and prior to the filing date of Petitioner's intent to use application.

IV. PETITIONER RAISES NO VALID CONSTITUTIONAL ARGUMENTS THAT WARRANT REVIEW BY THIS COURT.

Petitioner's various Constitutional arguments are meritless. Petitioner first summarily contends that he has been improperly denied a jury trial "to see whether he has statutory priority as of March 10, 1995, or otherwise filed in good faith." Petition at 19. Petitioner, however, failed to establish a genuine issue of material fact as to any of the elements of its claims. Summary judgment, as this Court has repeatedly held, is "not . . . a disfavored shortcut, but rather . . . an integral part of the Federal Rules as a whole which are designed to secure the just, speedy and inexpensive determination of every action." *Celotex Corp. v. Catrett*, 477 U.S. 317, 327 (1986). Entry of summary judgment did not violate Petitioner's right to a jury trial.

Petitioner's next contention, that the Seventh Circuit has unconstitutionally disregarded the Trademark Law Revision Act by "creat[ing] rights for [a] larger compan[y] contrary to a federal statute," (Petition at 20), is similarly baseless. As demonstrated above, the District Court and the Seventh Circuit did not make new law in this case. Respondents were properly held to have priority in the mark ST. LOUIS RAMS by reason of use and association of the name to designate the Rams team, *before* Petitioner filed its intent-to-use trademark application. Contrary to Petitioner's suggestions, the Seventh Circuit's application of the federal statute followed established precedent.

Petitioner's assertion of a violation of his "right" "to use and file [intent to use trademark applications] for the name St. Louis Rams," (Petition at 22-23), is misguided. As the Seventh Circuit found, Petitioner's "right" is subordinate to Respondents' prior established trademark rights.

CONCLUSION

Contrary to Petitioner's convoluted assertions, this is a routine trademark case in which the Seventh Circuit properly applied the law to the facts. There is no important question of federal law or policy to address, and no conflict with other Circuit Courts of Appeal. Petitioner's intent to use trademark application was correctly held subordinate to Respondents' rights arising from prior use of the mark. Finally, Petitioner's submission violated this Court's rules with respect to filing deadlines. For these reasons, the Petition for a writ of certiorari should be denied.

Respectfully submitted,

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(3)

No. 99-1066

IN THE SUPREME COURT OF THE UNITED STATES

JOHNNY BLASTOFF, INC.
Petitioner,
v.
LOS ANGELES RAMS FOOTBALL COMPANY, ST. LOUIS RAMS PARTNERSHIP, NATIONAL FOOTBALL LEAGUE PROPERTIES, INC., and NATIONAL FOOTBALL LEAGUE,
Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

REPLY TO BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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ARGUMENT

I.) THE SEVENTH CIRCUIT'S APPLICATION OF THE WRONG LEGAL STANDARD IN BLASTOFF WILL ENCOURAGE OTHER FEDERAL COURTS TO CONTINUE TO APPLY THE SAME INCORRECT LEGAL STANDARD

Respondents' Brief, at page 5, focuses in on a crucial aspect of the problem in Blastoff that the Supreme Court should address on certiorari:

> "The Seventh Circuit properly followed the well-accepted principle that [t]he determination of whether a party has established protectable rights in a trademark is made on a case by case basis, considering the **totality of the circumstances**. 'App. at A-10, citing New West, 595 F. 2d at 1200. In Lucent, the Third Circuit determined that the plaintiff, basing its claim of priority on a single sale of a product to an acquaintance of two officers of the company (see Lucent, 186 F. 3d at 317), failed to establish trademark rights superior to the intent to use applicant. In stark contrast, Respondents in this case amply **demonstrated** that prior to petitioner's application for registration, **use** of the mark ST. LOUIS RAMS was sufficiently widespread and public that a significant portion of the public identified the designation with the Rams Club. See App. at A-12."

The correct standard to be applied under Federal law for determining priority since the Trademark Law Revision Act of 1989 should be to require "use in the ordinary course of business," 15 USC 1051, 15 USC 1057, 15 USC 1127, not the more nebulous "totality of the circumstances." The Seventh Circuit in Blastoff ignored the requirement of "use in the ordinary course of business" and, instead, applied the "totality of the circumstances" standard. The record is clear and undisputed that there was no use in the ordinary course of business by any of the defendants. Frankly, defendants don't even make an "ordinary course of business" argument because they cannot on the record in this case. The "totality of the circumstances" standard applied from the New West case by the 9th Circuit in 1979 is entirely too unpredictable, and it was superseded by the use in the ordinary course of business requirement of the Trademark Law Revision Act (1989). In Blastoff, the Seventh Circuit regressed to pre-Act standards, thus perpetuating continued confusion and uncertainty which has lead to conflict and inconsistency between the circuits, and for which issue it is now necessary and ripe for Supreme Court correction in this case.

II.) CONFLICTING FACTS CUT AGAINST THE NFL DEFENDANTS, AND EVEN THEIR OWN RESPONSE BRIEF CONTAINS NO EVIDENCE OF ANY USE IN THE ORDINARY COURSE OF BUSINESS

Media speculation was also that the Los Angeles Rams would stay in Los Angeles, R-42, at #56, and, that *a fortiori*, if the NFL allowed a team to locate a franchise in St. Louis in the new St. Louis Stadium, it would be known as the "St. Louis Stallions". In fact, NFL Properties made authorized public representations that they had adopted and selected the name "St. Louis Stallions." The "NFL loved the name St. Louis Stallions" and wouldn't likely change it for the whims of any team owner. NFL Properties Vice President Rodger Goodell quoted in the St. Louis Post-Dispatch, Nov. 21, 1993. St. Louis Rams Partnership Vice President Bob Wallace's Deposition, Exh. #6, Widule Aff. at R-41, Exh. #47. When Blastoff's ITU's were filed, Blastoff was aware of the undisputed opposition of the NFL to a relocation of the Los Angeles Rams and of the reservation by the NFL with the U.S. Patent and Trademark Office of the name "St. Louis Stallions." The NFL was aware of Blastoff's filings at least as early as July 18, 1995, and should have been by March 10, 1995, and certainly by April 19, 1995. R-42, at #61.

This is the NFL we are talking about, boasting one of the premier trademark protection programs in the world, National Football League v. Wichita Falls Sportswear, Inc., 532 F. Supp 651, 656 (W.D. Wash.

1982). R-42, #20, p. 9. Now the NFL, at their Brief at page 2, rely for their rights upon

(i) a media report that a bar owner may have started a "St. Louis Rams" fan club (Did he really? Wasn't this just a press report too? Does it matter? Isn't it more important and significant that NFL Properties, exclusive licensor of all NFL trademarks and which had specifically prohibited any use of the name St. Louis Rams, <R-42 at #22(xiii), p. 16>, had a "St. Louis Stallions fan club" since 1993? <R-43, at #102>);

(ii) that season tickets were presold for "an NFL franchise" (not for "St. Louis Rams");

(iii) that the mayor of St. Louis is reported to have wanted the "St. Louis Rams" (or any other NFL team); and

(iv) that the St. Louis Post Dispatch indicated a desire for the name "St. Louis Rams" by printing the name on January 18, 1995. ("It is not official until the Commissioner and the owners sing", St. Louis Post-Dispatch,1/18/95; R-42, at #56, pg.24). Georgia Frontiere actually stated at the 1/17/95 unauthorized press conference: "I'm overwhelmed, I don't think I've been this happy since the last game we won" USA Today, 1/18/95, Heberer Aff. R-34, Exh. G. p. 1; R-42 at #11.

This is not use of the trademark at issue in the ordinary course of business. This is not adoption of a trademark by Respondents, or by anyone else.

III.) PETITIONER'S PETITION COMPLIES WITH SUPREME COURT RULES, AND IT IS THE NFL THAT DIDN'T FOLLOW THE RULES

Petitioner's petition for writ of certiorari is timely; was accepted as filed, and complies with all Supreme Court rules. Petitioner did not "evade" anything by timely seeking review and filing its Petition in the time period as ordered. Likewise, the merits of this case are that Johnny Blastoff, Inc. complied with all USPTO and Federal laws for trademark protection, but the NFL didn't. Don't let the person who complies with the rules, performs a search and files his ITU's with a bona fide intention to use be run over by large companies with no use and no filing.

IV.) RAMS IS GENERIC AS APPLIED TO THIS CASE

In Illinois High School Association v. Vantage, 99 F. 3d 244 (7th Cir. 1996), the Seventh Circuit noted that "for the sake of protecting effective communication it should be resolved against trademark protection, thus assimilating dual-use or multiple-use terms to generic terms." If the NFL wants to use the nickname "Rams", they should go right ahead, but that should not stop anyone else from using the nick-name Rams, including Blastoff. Id. The team name "St. Louis Rams" is a different story. That is not a generic term like the nickname "Rams". There is a recognized difference between team names and nicknames. National Football

League v. Wichita Falls Sportswear, Inc., 532 F. Supp 651, 656 (W.D. Wash. 1982) ("Seattle Seahawks" is the team name, while "Seahawks" is the nickname.) Blastoff's earlier ITU's, however, should carry the day for the name St. Louis Rams. 15 USC 1051, 15 USC 1057, 15 USC 1127. The "use" which the NFL wants this Court to reaffirm or find as having "demonstrated", is simply not use by defendants in the ordinary course of business as a matter of law. Lucent, 186 F. 2d 311 (3rd Cir. 1999), cert. denied on January 10, 2000; 15 USC 1057(c); 15 USC 1127.

V.) THE NFL'S OWN ROSTER CONFIRMS THE FALLACY OF THE NFL's ARGUMENTS

The NFL's "Tennessee Titans" team clearly demonstrates that, contrary to the NFL's assertions, an NFL team with a "city-based" geographical component ("Houston Oilers") may relocate and have a "state-based" geographical component (Tennessee rather than Nashville); and, that the team's nickname prior to relocation ("Oilers") doesn't mean it stays that way after relocation ("Titans").

VI.) THIS IS NO ROUTINE TRADEMARK CASE WHERE THE COURTS ACTED PROPERLY

This is no routine trademark case, it is a reverse confusion case, where not only did both lower courts apply the wrong legal standard, but have fostered continued uncertainty for businesses who utilize the

USPTO and federal law upon which to base their product naming and branding decisions.

VII.) PETITIONER ACCURATELY STATES THE RECORD; RESPONDENTS, HOWEVER, INAPPROPRIATELY LUMP TOGETHER "LOS ANGELES RAMS FOOTBALL COMPANY" WITH "ST. LOUIS RAMS PARTNERSHIP"

Petitioner accurately states the record. Respondents; at Brief page 1, however, assert the following definitions: "Los Angeles Rams Football Company, St. Louis Rams Partnership (together, the "Rams" or the "Rams Club") ---."

This implication of continuity is misleading and is indicative of much of the problem. There is no evidence of continuous use of the name St. Louis Rams by defendants until after April, 1995. R-42, #21. Los Angeles Rams Football Company changed its name to Rams Football, Inc. on April 14, 1995. R-43, #98, p. 3. St. Louis Rams Partnership includes owner Stan Kroenke, of Wal-Mart fame, R-42, at #121, operating as "ITB Football" since 2/8/95; R-43, at #98, pg. 3-4, and St. Louis Rams Partnership wasn't even formed until July of 1996. Id. At R-42, p. 1, Petitioner pointed out this objection to both lower courts:

"Response To Definitions: The definition of 'Rams' is vague and misleading, as 'Los Angeles Rams Football Company' and 'St. Louis Rams Partnership' are separate entities, with different owners, and the latter of which was not formed until after April 12, 1995, in fact,

on July 6, 1996." There was no actual continuity of use as required by Zazu Designs v. L'Oreal, S.A., 979 F2d 499, 503 (7th Cir. 1992). R-43 at #98, p.3.

Judge Posner recognized the obvious truth in Indianapolis Colts Inc. v. Metropolitan Baltimore Football Club Ltd. Partnership, 34 F. 3d 410, 412 (7th Cir. 1994) that an NFL team can only be in one place, at one time, with one name:

"Well, of course, they (Indianapolis Colts) were no longer playing football under the name 'Baltimore Colts', so could not have used the name as the teams trademark; they could have used it on merchandise but chose not to...." Id; R-42, at #91.

Likewise, the Respondents could have adopted or used the mark St. Louis Rams prior to 3/10/95, **but chose not to** (e.g. Press release by "L.A. Rams" on 2/8/95; R-43, at #21(b).). After discovering Blastoff's ITU filings, the NFL had the last clear chance to avoid this collision by not adopting or using the team name St. Louis Rams. Instead, they decided to out-muscle Blastoff just like they did to the existing wheelchair Baltimore Ravens basketball team in Baltimore. R-43, @ #54.

VIII.) BLASTOFF WAS UNABLE TO OVERCOME THE PUBLIC FEAR CREATED BY THE NFL'S TRADEMARK PROGRAM AND ITS USE OF THE NAME ST. LOUIS RAMS AFTER BLASTOFF'S ITU's WERE FILED

At its Brief, page 5, the NFL cites New West for the proposition that public perceptions are important to this

case. They are, but for a reason different than as proposed. Some background is in order:

Johnny Blastoff, Inc. worked in early 1994 with Reggie White to try to dovetail Blastoff's product development with Reggie's urban renewal and ministry efforts. R-43 @ #6. Blastoff wanted to encourage development of sports teams and clothing products for people in inner cities, both in imaginary cities (e.g., Reggieville Rappertiers, Reggieville Sluggers, Tower City Rams) as well as in real urban centers (St. Louis Rams, Phoenix Scorpions, Orlando Werewolves, Monterrey Cheetahs), Id. Blastoff promoted a Tower City Football League to play in imaginary as well as real cities (so the real city fans could better identify to the fictitious team), e.g., St. Louis was a real urban city that had a brand new vacant football stadium at the time (i.e. 1993-early 1995), Id, @ #7, #17-5. Tower City, home of the Johnny Blastoff cartoon character, See, e.g., http//www.johnnyblastoff.com., was conceived by Blastoff since 1993 as also being a futuristic version of the city of St. Louis. R-43, at #22-d, #65. Blastoff couldn't get shirts printed and distributed in May of 1995 by a major distributor due to the distributor's fear of the NFL even though Blastoff's president Rodney Rigsby had shown Blastoff's prior-filed ITU's to the distributor. R-43 at #93. Rigsby was arrested in Madison, Wisconsin in 1997 for trying to sell Blastoff's St. Louis Rams shirts at a U-2 concert in Madison. Id. This is a classic case of reverse confusion. Sands, Taylor and Wood Co. v Quaker Oats Co. 978 F. 2d 947, 957 (7th Cir. 1992).

It is also unfair competition, Id, 15 USC 1125, because the NFL's over-aggressive licensing and trademark

protection practices engender in the public the mistaken notion that trademark protection extends further than it does. J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition (3rd Ed.), Sec. 24.9; R-42 at #20, pg. 9. The NFL sent out cease and desist letters to Blastoff based upon registrations for "Rams" and "Los Angeles Rams", R-43 at #6, and so advised some of Blastoff's potential customers. Id. Public perception is important in this case, but not because it created non-existent rights for the NFL (because it didn't), but because the NFL's power and conduct prevents Blastoff from fair competition. Id. The NFL's standard business practice is to assert federal trademark registration status to the public, even when they don't have it. R-42 @ #19. That is not right. Neither is allowing the NFL to control all products in all product categories. Sands, Taylor and Wood Co. v. Quaker Oats Co. 978 F. 2d 947 (7th Cir. 1992).

IX.) CONCLUSION

Contrary to the Respondent's conclusion, the Petition for Writ of Certiorari should be granted.

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